

Neifeld Docket No: CAT/29US-SCROCO

Application/Patent No: 09/401,939

USPTO CONFIRMATION NO: 5333

File/Issue Date: 9/23/1999

Inventor/title: Scroggie/System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: Janvier/3688

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 SECOND REPLACEMENT APPEAL BRIEF

Sir:

In response to the notice of non-compliant appeal brief mailed April 21, 2008, further to the notice of non-compliant appeal brief mailed March 31, 2008, further to the order returning undocketed appeal to examiner mailed November 29, 2007, further to the reply brief filed April 6, 2007, further to the examiner's answer mailed February 27, 2007, further to the appeal brief filed November 10, 2006, further to the office action mailed August 11, 2006, in addition to the "37 CFR 1.181 PETITION TO WITHDRAW THE NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF DATED MARCH 31, 2008", and in addition to the "37 CFR 1.181 PETITION TO WITHDRAW THE NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF DATED APRIL 21, 2008", the appellant submits this 37 CFR 41.37 replacement appeal brief.

The BPAI will not accept the appeal until decision on the foregoing petitions are rendered. Therefore, the examiner is urged to expedite obtaining decisions on those petitions.

Table of Contents

I.	37 CFR 41.37(c)(i) - The real party in interest	<u>4</u>
II.	37 CFR 41.37(c)(ii) - Related appeals and interferences	<u>4</u>
III.	37 CFR 41.37(c)(iii) - Status of Claims	<u>6</u>
IV.	37 CFR 41.37(c)(iv) - Status of Amendments	<u>6</u>
V.	37 CFR 41.37(c)(v) - Summary of Claimed Subject Matter	<u>6</u>
VI.	37 CFR 41.37(c)(vi) - Grounds of Rejection to Be Reviewed on Appeal	<u>8</u>
VII.	37 CFR 41.37(c)(vii) - Argument	<u>8</u>
VIII.	Whether the Rejection of all of Claims 32-76, Except for Claims 34, 36, 47, 60, 72-74, and 76, Under 102(b) Based upon Nichtberger USP 4,882,675, Should be Reversed	<u>8</u>
A.	Nichtberger	<u>9</u>
B.	Claim 32	<u>12</u>
C.	Nichtberger does not disclose claim 32's "transmitting ... to a personal computer."	<u>12</u>
D.	Definition of "personal computer"	<u>13</u>
E.	Dependent Claims up to Claim 33-39 and 71-76	<u>15</u>
F.	Claims 45-70	<u>17</u>
G.	Response to the Examiner's Arguments Regarding Claim 32; Nichtberger's Local CDR Unit 20 is Not a Personal Computer and Does Not Correspond to the Claimed "Personal Computer"	<u>17</u>
H.	Response to the Examiner's Arguments Regarding Dependent Claims	<u>18</u>
IX.	Whether the Rejection of Claims 34, 47, 60, and 71-76 under 103 based upon Nichtberger USP 4,882,675 Should be Reversed	<u>18</u>
X.	Whether the Obviousness Rejections of Claims 72-74 and 76 under 35 USC 103 based upon Nichtberger USP 4,882,675 and Barnett USP 6,321,208 Should be Reversed	<u>19</u>
XI.	Whether the Rejection of Claims 32, 44, 45, 57, 58, 70, and 74, Characterized as an	

	Objection and a Requirement to Amend, for Each Claim, Should Be Reversed . . .	<u>21</u>
XII.	37 CFR 41.37(c)(viii) - Claims Appendix	<u>23</u>
XIII.	37 CFR 41.37(c)(ix) - Evidence Appendix	<u>23</u>
XIV.	37 CFR 41.37(c)(x) - Related Proceedings Appendix	<u>23</u>

I. **37 CFR 41.37(c)(i) - The real party in interest**

The real party in interest is Catalina Marketing Corporation, a Delaware Corporation.

II. **37 CFR 41.37(c)(ii) - Related appeals and interferences**

The following applications or patents have the same disclosure (cat/29us series) as the patent being reexamined.

1. CAT/29US-SCRCO2; 09/756,787; pending
2. CAT/29US-SCRCO3; 09/756,788; pending
3. CAT/29US-SCRCO4; 11/449,596; abandoned
4. CAT/29US-SCRO; 08/905,501; 6,014,634 (under reexamination)
5. CAT/29US-SCROCO; 09/401,939; pending
6. CAT/29US-SCROD1; 09/401,198; pending
7. CAT/29US-SCROD2; 09/410,086; pending
8. CAT/34-SCRO-CCP; 09/505,632; pending
9. CAT/34-SCRO-US; 08/873,974; pending

The following applications or patents have less than the entire disclosure (cat/29 series), lacking Figs. 16-18 and the description thereof in the patent being reexamined.

10. CAT/29-SCRO; 08/622,685; 5,970,469
11. CAT/29-SCRO-CO; 09/310,382; 6,185,541
12. CAT/29-SCRO-CO2; 09/478,351; pending
13. CAT/29-SCRO-CO3; 5/9/2000; abandoned
14. CAT/29-SCROCO4; 09/716,404; 6,885,994
15. CAT/29-SCROCO5; 11/019,217; 7,233,913

The following subsections 1-16 identify any related proceeding, and identify attachments for decisions from those related proceedings.

1. CAT/29US-SCRCO2; 09/756,787; pending
Status of appeal: BPAI Appeal No. 2007-4321.
2. CAT/29US-SCRCO3; 09/756,788; pending, appeal brief filed 10/17/2006.
3. CAT/29US-SCRCO4; 11/449,596; abandoned.
4. CAT/29US-SCRO; 08/905,501;

Status: Issued as U.S. Patent 6,014,634 (under reexamination).

5. CAT/29US-SCROCO; 09/401,939; pending

Status of appeal: Appeal pending (subject of this appeal).

A copy of the BPAI Decision on Appeal November 22, 2004 is Appendix 3, Attachment 3-b.

A copy of the BPAI Decision on Request for Rehearing March 14, 2005 is Appendix 3, Attachment 3-b1.

6. CAT/29US-SCROD1; 09/401,198; pending

Non-final office action mailed January 25, 2008.

A copy of the BPAI Decision on Appeal November 30, 2004 is Appendix 3, Attachment 3-c1.

A copy of the CAFC Decision March 13, 2006 is Appendix 3, Attachment 3.

7. CAT/29US-SCROD2; 09/410,086; pending

BPAI return before appeal September 29, 2006.

8. CAT/34-SCRO-CCP; 09/505,632; pending

Reply brief noted by examiner April 2, 2008.

9. CAT/34-SCRO-US; 08/873,974; pending

BPAI decision reversing examiner January 29, 2008.

A copy of the BPAI Decision January 29, 2008 is Appendix 3, Attachment 3-d.

The following applications or patents have less than the entire disclosure (CAT/29 series), lacking Figs. 16-18 and the description thereof, which disclosure is present in the patent being reexamined.

10. CAT/29-SCRO; 08/622,685;

Status: Issued as U.S. Patent 5,970,469

11. CAT/29-SCRO-CO; 09/310,382;

Status: Issued as U.S. Patent 6,185,541

12. CAT/29-SCRO-CO2; 09/478,351;

Status: pending

BPAI Return Before Appeal November 14, 2007.

13. CAT/29-SCRO-CO3; 09/567,274;
Status: abandoned.
**CAFC Appeal Docket No 05-1353; decision dated 2/10/2006 affirmance, per curium.
BPAI decision on reconsideration dated 1/30/2005 is Appendix 3, Attachment 3-a1.
BPAI decision on appeal dated 8/17/2004 is Appendix 3, Attachment 3-a.**
14. CAT/29-SCROCO4; 09/716,404;
Status: issued as U.S. Patent 6,885,994
15. CAT/29-SCROCO5; 11/019,217;
Status: Issued as U.S. Patent 7,233,913.

III. **37 CFR 41.37(c)(iii) - Status of Claims**

Claims 1-31 canceled.

Claims 32-76 are pending, rejected, and appealed.

IV. **37 CFR 41.37(c)(iv) - Status of Amendments**

No amendment has been filed subsequent to final rejection.

V. **37 CFR 41.37(c)(v) - Summary of Claimed Subject Matter**

The claimed subject matter of independent claim 32 defines a computer implemented method for distributing purchasing incentives to consumers, comprising the steps of:

(1) transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer (Title, abstract, page 1 lines 17-25, 29-30, Page 4 lines 13-16, Page 5 line 26 to page 6 line 2, Fig. 3 blocks 106-118, user PC 302 connecting via the Internet 304 to an online incentive distribution server 300, Page 25 lines 2-10) over a computer network (page 1 lines 27-30 and page 9 lines 6-8);

(2) displaying said plurality of product discounts at said personal computer based on said promotion data (page 8 line 28 through page 9 line 9);

(3) transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said

computer network (page 2 lines 7-8);

(4) generating token data depending on said selection data (page 19 lines 1-7);

(5) transmitting said token data from said main computer to said personal computer over said computer network (page 18 line 21 through page 19 line 7);

(6) identifying said token data in a retail store in association with items being purchased at said retail store (page 19 lines 8-12);

(7) determining discount items being purchased corresponding to said at least one product discount from said identified token data (page 19 lines 1-12); and

(8) generating a purchase incentive based on said discount items (page 16 lines 6-15).

The claimed subject matter of independent claim 45 defines a computer implemented system for distributing purchasing incentives to consumers, comprising:

(1) a computer network (page 18 lines 16-17, Fig. 13 icon 304);

(2) at least one personal computer (page 18 line 16, Fig. 13 icon 302);

(3) a main computer coupled to said at least one personal computer via said computer network and configured to transmit promotion data identifying a plurality of product discounts to said at least one personal computer over said computer network (Title, abstract, page 1 lines 17-25, 29-30, Page 4 lines 13-16, Page 5 line 26 to page 6 line 2, Fig. 3 blocks 106-118, user PC 302 connecting via the Internet 304 to an online incentive distribution server 300, Page 25 lines 2-10) over a computer network (page 1 lines 27-30 and page 9 lines 6-8);

(4) said at least one personal computer configured to display said plurality of product discounts based on said promotion data (page 8 line 28 through page 9 line 9);

(5) said at least one personal computer configured to transmit selection data designating at least one product discount selected from said plurality of product discounts to said main computer over said computer network (page 2 lines 7-8);

(6) said main computer configured to generate token data depending on said selection data (page 19 lines 1-7);

(7) said main computer configured to transmit said token data to said at least one personal computer over said computer network (page 18 line 21 through page 19 line 7);

(8) a retail store configured to identify said token data in association with items being purchased at said retail store (page 19 lines 8-12);

(9) said retail store configured to determine discount items being purchased corresponding to said at least one product discount from said identified token data (page 19 lines 1-12); and

(10) said retail store configured to generate a purchase incentive based on said discount items (page 16 lines 6-15).

The claimed subject matter of independent claim 58 defines a computer program for distributing purchasing incentives to consumers, including structure or code for performing the following steps:

(1) transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network (Title, abstract, page 1 lines 17-25, 29-30, Page 4 lines 13-16, Page 5 line 26 to page 6 line 2, Fig. 3 blocks 106-118, user PC 302 connecting via the Internet 304 to an online incentive distribution server 300, Page 25 lines 2-10) over a computer network (page 1 lines 27-30 and page 9 lines 6-8);

(2) displaying said plurality of product discounts at said personal computer based on said promotion data (page 8 line 28 through page 9 line 9);

(3) transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network (page 2 lines 7-8);

(4) generating token data depending on said selection data (page 19 lines 1-7);

(5) transmitting said token data from said main computer to said personal computer over said computer network (page 18 line 21 through page 19 line 7);

(6) identifying said token data in a retail store in association with items being purchased at said retail store (page 19 lines 8-12);

(7) determining discount items being purchased corresponding to said at least one product discount from said identified token data (page 19 lines 1-12); and

(8) generating a purchase incentive based on said discount items (page 16 lines 6-15).

The claimed inventions also provide computer implemented systems and methods (dependent claims 33-44, 46-57 and 59-70) for generating said purchase incentive comprises generating an instantly redeemable voucher (page 24 lines 21-28), generating said purchase incentive comprises generating a voucher that is redeemable on a subsequent visit to said retail store (page 24 lines 21-28), generating a shopping list based on said selected product discounts (page 14 lines 13-21), transmitting said shopping list from said main computer to said personal computer over said computer network (page 9 lines 10-17), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer (page 18 lines 21-30), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer (page 18 lines 21-30), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer (page 21 lines 14-21), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of tokens by a consumer (page 20 lines 17-24), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer (page 20 lines 17-24), identifying said token data comprises identifying said token data by scanning a token having said token data therein (page 24 lines 21-26), said computer network comprises one of an intranet and the Internet (page 16 line 7 and Fig. 13, item 300).

The claimed inventions also provide computer implemented systems and methods (dependent claims 71-76) operated using a personal computer from outside the supermarket, such as at the consumer's home (see above), and logging on to the web site (Fig. 2, block 80, page 7 lines 22-23).

VI. 37 CFR 41.37(c)(vi) - Grounds of Rejection to Be Reviewed on Appeal

Whether the Rejection of Claims 32-76, except for claims 34, 36, 47, 60, 72-74, and 76, under 102(b) based upon Nichtberger USP 4,882,675, should be reversed.

Whether the rejection of claims 34, 47, 60, and 71-76 under 103 based upon Nichtberger USP 4,882,675 should be reversed.

Whether the rejection of claims 72-74 and 76 under 35 USC 103 based upon Nichtberger USP 4,882,675 and Barnett USP 6,321,208 should be reversed.

Whether the rejection of claims 32, 44, 45, 57, 58, 70, and 74, characterized as an objection and requirement to amend, for each claim, should be reversed.

VII. 37 CFR 41.37(c)(vii) - Argument

Argument is presented for each of the four grounds in the following four sections.

VIII. Whether the Rejection of all of Claims 32-76, Except for Claims 34, 36, 47, 60, 72-74, and 76, Under 102(b) Based upon Nichtberger USP 4,882,675, Should be Reversed

The examiner rejects all of claims 32-76, except for claims 34, 36, 47, 60, 72-74, and 76, for anticipation based upon Nichtberger USP 4,882,675. These rejections should be reversed for the following reasons.

A. Nichtberger

Nichtberger is directed to a paperless system for distributing, redeeming, and clearing merchandise coupons. Title. It discloses electronic distribution and redemption of cents off merchandise coupons. First sentence of the Abstract. It discloses that "The items purchased in the store by the customer are recorded, and any matches between the coupons selected and the items purchased are determined electronically. The customer is immediately credited in accordance with the terms of the matched coupons." Fifth and sixth sentences of the Abstract.

Nichtberger discloses in the description of Figure 1 that the user presents an identification card in a retail store to a location station 10 in the retail store, the CDR unit 20 of the local station 10 displays coupon offers for the retail store to the user, the user selects coupon offers, and the local station stores the selected coupon offers in association with the user's identification for retrieval by the automated UPC scanning checkout system 18. The user then presents items for purchase and the user's identification at the checkout 18. The system retrieves the selected

coupon offers associated with the user's identification and credits the amount of each coupon for products in the user is purchasing to the user during the user's purchase transaction. The system transmit redemption information to the central processing unit 16 for accounting to the manufacturer (coupon sponsor) and retailer.

Fig. 4 deals with the process steps of coupon distribution and redemption. It indicates that the CDR unit 20 may print a shopping list, but specifies that this list is only for the user's, and is not a coupon or voucher, stating that "After the last screen is seen, and a user decision made, the "account choice" record is created, and a receipt or shopping list may be printed. The receipt includes a receipt number, the product name and size, and the savings amount. It is used as a reminder to shoppers and can be used to identify the users of cards which are not special cards at checkout time."

In an alternative to Fig. 4 applicable to shoppers that do not yet have suitable identification card, Nichtberger discloses "During the introductory period, customers without a special card will instead be allowed to utilize selected cards having a magnetic stripe to activate the CDR unit 20. In this case, the number printed on the receipt or coupon selection reminder can have operational significance if the receipt does not bear the account number and if the card does not display the account number in UPC code format. The customer shops as indicated at 68, and proceeds to the checkout station, as indicated at 70. Since the reminder bears the number under which the customer's selections are filed by the CDR unit 20, it is presented at checkout time in lieu of the special card." That is, the printed shopping list also contains in print for the coupon selection list's identification number. In an alternative to Fig. 4 applicable to all users, Nichtberger also discloses printing a receipt number on the user's shopping list and associating that receipt number with the user's selections, stating that "When the customer has completed the selection of one or more coupons from each of the available coupon screens, a list of his selections is printed by the printer 94 and dropped into a coupon selection list dispensing tray so that he will be reminded of the savings he can realize on the selected items as he shops. He is assigned a receipt number which is printed on the coupon selection list. That receipt number allows the system to match up the customer's selections with his purchases to effect a redemption at checkout time in lieu of the special card."

In another alternative in the last sentence of the specification, Nichtberger discloses storing coupon selections in the user's card, stating that "A still further possibility is that information regarding the coupons selected by a customer could be recorded on the customer's special card at the time of coupon selection. The information recorded on the card could then be read directly at the checkout station for redemption and subsequent clearing."

Nothing in Nichtberger either discloses or suggests Internet connections. In fact, what Nichtberger discloses for its communications between the supermarkets and the central computer are dial up modem communications, stating "The modem 100 is used to communicate with the central processing unit 16 over the dial-up telephone network (DDN). The modem is designed to operate at 300, 1200 and 2400 baud (bits per second) and to operate either in the synchronous or the asynchronous mode."

Nichtberger discloses that the data written to the magnetic stripe of the card is time and date data, stating that "When a card is inserted into card reader 92, the device reads the customer number and expiration date encoded on one of the magnetic tracks on the card in ABA format. A security code may but need not be included. It also reads a transaction date or time period code which was encoded on the other track in IATA format during the previous transaction, possibly along with other details of prior transactions, or other data. When the customer's identity and usage period have been validated, he is presented with a screen of coupon choices from which to make a selection." This card function is important because Nichtberger also discloses limiting selections to once per week, and the time of selections is recorded in the magnetic card for this purpose; to validate the right of the user to make selections.

Nichtberger also disclose an alternative method for a consumer to make selections, via telephone, stating that "Consumers could call a local telephone number to contact the local processing unit (LPU). The LPU would advise the identified consumer of coupons offered that week. After choosing coupons, the consumer could also choose to shop for supermarket items on the system. After the customer hangs up, the LPU may send the user's file to the appropriate supermarket's CDR unit."

Nichtberger also discloses a limited form of targeting, stating that "An important feature of the invention is that a customer's demographic information may be magnetically encoded on

the card such that when the customer is identified by CDR unit 20, possibly by spoken name, certain select coupons will be shown to the particular individual who meet preselected criteria. This would allow a manufacturer to give coupons to customers (for example) who chose another manufacturer's coupons the preceding week. It would also allow many coupons to be in the system, without displaying all coupons to all customers." and "In accordance with the invention, all of the products purchased by a customer could be "saved" in a modified kiosk, or, alternatively, in the POS system storage. Those purchases could then be associated with the purchaser, whose name and data would be known."

Finally, Nichtberger discloses that the supermarket and the central computer may be "online" stating "The system may be "on-line" wherein constant communications between an operations center and local stations would allow customers to use various supermarket CDR units within one week, because their prior selections can be retrieved from the operations center. Each user could also be specifically identified by last week's purchases or coupons or any other variable that is stored in the substantial data base in the operations center."

B. Claim 32

Claim 32 recites:

32. (Previously presented) A computer implemented method for distributing purchasing incentives to consumers, comprising:

- transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

- displaying said plurality of product discounts at said personal computer based on said promotion data;

- transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

- generating token data depending on said selection data;

- transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

C. Nichtberger does not disclose claim 32's "transmitting ... to a personal computer."

Nichtberger does not disclose claim 32's "transmitting ... to a personal computer." In fact, the examiner agrees that Nichtberger does not disclose a personal computer, stating at office action page 12 lines 5-9 that "As per claims 72-74 and 76, Nichtberger does not expressly disclose using a personal computer or a terminal, located at home or outside the retail store, to log onto a web site of the main computer or operation center central computer prior to transmitting promotional data (the personal computer remotely accesses the central computer or main computer to select coupon data...)." ."

Nichtberger also discloses allowing a user to enter selections by using a telephone prompt system. However a telephone prompt system is not a personal computer, as defined by claim 32.

D. Definition of "personal computer"

This application contains many passages explaining the meaning of a personal computer. This application is directed to "System and method for providing shopping aids and incentives to customers through a computer network." Title. It discloses in the Abstract "A system and method for delivering purchasing incentives and a variety of other retail shopping aids through a computer network, such as by E-mail over the Internet or the World Wide Web. Customers (10) of retail stores can establish a bidirectional communication link with the system." The reference to the World Wide Web in connection to customers of retail stores suggests use of personal computers owned by the customers. The Abstract also discloses that "For purchase incentives redeemable at retail stores, the customer must provide identification information and must also designate a retailer (12) at which the purchasing incentive can be exercised." This passage

explains that the customer is interacting via a computer not part of the retail store system, that is, not a terminal of that system. Moreover, the statement in the abstract that "Instead, the terms of the incentive are transmitted electronically to the retail store (310) designated by the customer, who receives either a token (316) to present at the store or an advisory message." also indicates that the customer is not using part of the retail store computer system and is interacting with the retail store computer system from a remote location, such as the customer's home.

In the Background section, this application states that "In recent years, an increasing number of retail store customers also own personal computers and, of these, many have access to computer network services that provide connections to the Internet and the World Wide Web. Although some computer sites connected to the World Wide Web have begun to offer 'online' shopping services, and some services have proposed to deliver discount coupons through a computer network, the full potential of online delivery of incentives has not been realized prior to the present invention." This passage indicates that the invention is based upon retail store customers using their own personal computers to interact online via the World Wide Web.

In the Summary of the Invention section, this application states that "Importantly, the incentives are distributed in such a way that they may be redeemed only at a specific retailer selected by each customer." Page 1 lines 29-30. This statement indicates that the consumers are not using a particular retailer's system, since such a system would allow the customer to select a different retailer, and instead implies that the consumers are using their personal computers.

In the Summary of the Invention section, this application states that "The invention may also be defined in terms of a system for distributing purchasing incentives to retail customers, the system comprising a communication network establishing bidirectional communication between a central site and each of a plurality of customer devices...." Page 4 lines 13-16. Obviously, a plurality of customer devices indicate that those devices are customer devices, not part of a store computer system; that is personal devices, such as personal computers.

In the Summary of the Invention section, this application states that "Implementation of the invention in the form of a network site, such as a World Wide Web site, represents a significant departure from prior, conventional uses of Web sites for commercial purposes. Instead of being administered by or for a single commercial entity, the Web site through which

customers communicate in accordance with the present invention is a cooperative site involving both retailers and manufacturers, to provide customers with a variety of information, planning aids, and shopping incentives from multiple sources." Page 5 line 26 to page 6 line 2. This statement further confirms that the underlying concept and technology of the invention is use of the World Wide Web. That use is consistent with personal computers used at home by consumers connecting to web sites, and it is not consistent with a terminal connected to a computer system.

Fig. 3 shows decisional blocks 106-118 referring to IP address validation and tracing only applicable to packet switched network configurations such as the Internet, in the Log on process for a consumer. This also indicates that the concept of the application refers to consumers user personal computers to interact with a web site, not consumers in a store using a store terminal to communicate with a store computer.

Fig. 13 expressly shows the user PC 302 connecting via the Internet 304 to an online incentive distribution server 300. Similarly the descriptions of Figs. 13-18, including the references to emailing to consumers, URLs, personal web pages, and online, all require use of the Internet and World Wide Web to make any sense.

Moreover, the description of the token and voucher programs specifically refers to the users computer as their home computer in describing benefits of these programs, stating that "The token and voucher program provides advantages for all parties to each transaction. First, for manufacturers there is increased security for promotions introduced by computer networks such as the Internet. Instead of printing potentially reproducible monochrome coupons that are effectively redeemable for cash, the user's home computer generates a token that has to be taken to a store at which the qualifying products must be purchased by user before a cash voucher is generated. Since the token system ensures that the discounted products are purchased, the manufacturer pays only for positive results for each incentive offered. Moreover, the system avoids the inherent negative connotations of coupons." Page 25 lines 2-10.

From all of the foregoing, it is clear that the claimed personal computer means a computer personal to the consumer and that is capable of browsing the World Wide Web and sending and receiving emails. No element disclosed in Nichtberger has those capabilities and

features.

E. Dependent Claims up to Claim 33-39 and 71-76

Nichtberger does not disclose or suggest "generating said purchase incentive comprises generating [a] voucher" as recited in claims 33 and 34. In fact, Nichtberger's teaching to use electronic coupons teaches away from printing incentives at the point of sale. A voucher means "a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made." Nichtberger does not disclose providing a document that provides supporting evidence for a claim of entitlement to money. In fact, Nichtberger teaches away from using documents since it is direct to all electronic, no paper, processing of coupons. In fact, Nichtberger also teaches providing the discount associated with a purchase incentive as part of the transaction involving purchasing the product item associated with the incentive. In contrast,

the voucher defined by these claims entitles the consumer to obtain that discount as part of a separate subsequent transaction, and that concept does not exist in Nichtberger.

Nichtberger does not disclose or suggest "transmitting promotion data identifying a plurality of product discounts *on a basis of a frequency of usage of tokens by a consumer*," as defined by claim 41. Nothing in Nichtberger discloses that the transmitting of promotion data depends in any way upon the user's frequency of use of prior electronic coupons, whether or not they were defined by tokens carried by the user.

Nichtberger does not disclose or suggest "transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer," as defined by claim 42 for the same reason just presented for claim 41.

Nichtberger does not disclose or suggest that "computer network comprises one of an intranet and the Internet," as defined by claim 44. An intranet and the Internet are packed switched, asynchronous methods of communicating data to network addresses by using intervening nodes; computers running network software that each have a network address. The

Internet and intranets depend upon transmission of packets of data between locations. In contrast, Nichtberger discloses a modem connection between two computers, which necessarily requires direct time correlated synchronous signals for data transmission.

Nichtberger does not disclose or suggest that the "personal computer is located remote from said main computer," as defined by claim 71. Nichtberger also does not disclose or suggest that the "personal computer is located outside said retail store," as defined by claim 72. Nichtberger also does not disclose or suggest that the "personal computer is located at a home of a user of said personal computer," as defined by claim 73. All Nichtberger discloses for display to the user of coupons and selection by the user of coupons is the in-store local CDR unit 20, a terminal that is part of a computer system all components of which are located in a single supermarket. Those components are not remote from one another as defined by claim 71, Nichtberger's terminal is not located outside the retail store, as defined by claim 72, and Nichtberger's terminal is not located at a home of the user, as defined by claim 73.

Nichtberger does not disclose or suggest "logging said personal computer on to said web site of said main computer prior to said transmitting promotion data," as defined by claim 74. Nichtberger discloses neither packet switched network connections nor web sites. In fact, Nichtberger's date of publication in 1989 antedates the existence of the world wide web, which was created in the early 1990s.

Nichtberger does not disclose or suggest that a "personal computer is capable of logging on to a web site of said main computer," as defined by claim 76. In fact, Nichtberger's local stations 20 are described as part of the same computer system 20 including the UPC scanning and checkout system storing the coupon information. Therefore, no "logging on" is required at the local stations 20. The root word "log" does not appear in Nichtberger's text.

F. Claims 45-70

For the same reasons discussed above for claims 32-39, Nichtberger does not disclose or suggest claims 45-70.

G. Response to the Examiner's Arguments Regarding Claim 32; Nichtberger's

Local CDR Unit 20 is Not a Personal Computer and Does Not Correspond to the Claimed "Personal Computer"

In support of the anticipation rejections, the examiner asserts that a store terminal corresponds to the claimed personal computer, stating that "An electronic display of coupons valid for use in a particular store is presented to customers in that store via a terminal (personal computer)."

In response, the applicant points out Nichtberger does not disclose a personal computer presenting coupons to a consumer. Instead, it describes a component of a local retail store system, which it calls a "local CDR Unit" performing that function. Nothing in Nichtberger suggests that the "local CDR Unit" is personal, one to each consumer, is configured for Internet connection, email, and web browsing. In fact, Nichtberger's issue date precedes the existence of the WWW, and its filing date in 1984 long precedes the existence of the WWW and was prior to when stand alone computers were used as network nodes. Recall that the first commercially acceptable "personal computer" was introduced by Apple Computer on or around 1982. Thus, the examiner's assertion that the local CDR unit 20 was a personal computer is not supported by Nichtberger's disclosure. In addition, in the mid 1990s, the time frame to which this application claims priority, one skilled in the art in view of the facts noted above would not have understood Nichtberger's local CDR unit 20 to correspond to a personal computer.

The examiner asserts that Nichtberger does disclose using a LAN or WAN or Intranet, alleging "In general, coupon selection information is reported via a communications link or network (LAN or WAN or Intranet) to the local processor (for storage and later retrieval), which controls the store's automated checkout system." and citing to Nichtberger column 11 lines 46-50. However, Nichtberger column 11 lines 46-50 does not support that assertion. Nichtberger column 11 lines 46-50 states that "Coupon selection information is reported via a communications link to the local processor which controls the store's automated checkout (UPC code scanning) system, as indicated at 64. This facilitates a subsequent comparison of coupons selected to purchases made." Nothing in that quote suggests using a LAN or WAN or Intranet. Therefore, the examiner's implication that Nichtberger discloses networked technology is incorrect. Thus, there is no connection between Nichtberger's local CDR unit 20 and computer

structured to conduct network communications, such as the claimed personal computer.

H. Response to the Examiner's Arguments Regarding Dependent Claims

The examiner does not appear to have addressed in the anticipation rejections relying upon Nichtberger the limitations of the following dependent claims: 33, 34 (voucher); 41, 42 (frequency); 71, 72, 73, (personal computer location); 74 (log on), although the examiner rejected claims 33, 41, 42, 72, 73, and corresponding ones of claims 45-70 on this basis.

IX. Whether the Rejection of Claims 34, 47, 60, and 71-76 under 103 based upon Nichtberger USP 4,882,675 Should be Reversed

The examiner rejected claims 34, 47, 60, and 71-76 under 103 based upon Nichtberger USP 4,882,675. The appellant requests that these rejections be reversed for the following reasons.

Regarding the obviousness rejection of claims 34, 47, and 60 based upon Nichtberger, note that Nichtberger discloses an all electronic system of coupon generation, submission, and redemption in order to avoid paper coupons. It teaches away from use of paper. See for example the "Paperless system..." in Nichtberger's title. Claim 34 defined generating a voucher in response to a consumer purchasing previously selected items. The examiner argues that "As per claims 34, 47 and 60, although Nichtberger discloses adding or totaling individual incentives, associated with selected coupon items, based on the number of selected coupon items present in the customer's order during a transaction and applying the total individual incentives to the customer's purchase (See above)....." In response, the appellant points out that claim 34, 47, and 60 define generating a voucher, and the examiner has not alleged that Nichtberger discloses generating a voucher. In fact, Nichtberger teaches away from generating vouchers.

Regarding the obviousness rejection of claims 71-76 based upon Nichtberger, the examiner provided no basis for this rejection. In the office action, there is no argument, rationale, or reference to claims 71-76 in the obviousness rejection based solely upon Nichtberger. See office action pages 9-10. Accordingly, there is no basis on the record to maintain these rejections.

X. Whether the Obviousness Rejections of Claims 72-74 and 76 under 35 USC 103 based upon Nichtberger USP 4,882,675 and Barnett USP 6,321,208 Should be Reversed

The examiner rejects claims Claims 72-74 and 76 under 35 USC 103 based upon Nichtberger USP 4,882,675 and Barnett USP 6,321,208. These rejections should be reversed for the following reasons.

Nichtberger discloses a system for a consumer in a supermarket to select coupons for selected products, the supermarket to store the coupon selections, and the supermarket to award the consumer subsequently purchasing a selected product to have the value of the coupon credited to that consumer's transaction.

Barnett discloses a system in which a user using a personal computer at the user's home downloads from a central site computer a coupon book containing coupons for specified products. Title and abstract. Barnett discloses that the consumer subsequently uses those coupons during purchase to obtain a credit for the transaction in which the coupon is tendered, either by presenting a printed coupon in a physical retail store (column 11 lines 17-23) or during an online purchase transaction (column 11 lines 33-37).

There is no motivation to modify Nichtberger in view of Barnett because their system and processes are unrelated. Nichtberger discloses in store coupon selection and purchase process whereas Barnett discloses electronically sending a consumer a coupon book for the consumer to subsequently use. Nothing in Barnett suggests modifying the in store selection and purchase process of Nichtberger in any way.

The examiner argues that:

Therefore, an ordinary skilled artisan, implementing the system of Nichtberger, would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the coupon distribution system of Barnett into the Nichtberger's system so as to enable a user to use a home personal computer to remotely access, upon logging, a web site (interface) related to the central computer (main computer) over a communication link or the Internet to

select promotional coupons stored in the central computer database, wherein printable generated coupon data corresponding to the user's selections are electronically transferred to a redemption retail store database for permanent storage pending the purchase by the user of one or more matching products when the user identifies himself via a customer's loyalty card, thereby allowing millions of users to select in real-time promotional coupons, stored in the central computer database, by remotely accessing the central computer over a communication link or the Internet on a twenty-four hours, seven days a week and 365 days a year basis regardless of their geographic locations, while receiving redeemed coupon data from the redemption stores in real-time.

The examiner's argument lacks a motivation why one of ordinary skill would have wanted to "incorporate the coupon distribution system of Bamett into the Nichtberger's system." The examiner cites no teaching in the references providing a motivation to modify Nichtberger in view of Barnett. Accordingly, the rejections of claims 72-72 and 76 are improper and should be reversed.

XI. Whether the Rejection of Claims 32, 44, 45, 57, 58, 70, and 74, Characterized as an Objection and a Requirement to Amend, for Each Claim, Should Be Reversed

Previously, the BPAI rendered a decision on an appeal in this application in which the relevant holdings in the BPAI decision were as follows:

reversed all 112, 1st paragraph rejections of claims 32-70 for lack of enablement of "transmitting selection data", noting that the specification page 9 lines 4-5 enabled a customer selecting a coupon after log in;

reversed all 112, 1st paragraph rejections for lack of written description of "generating token data", noting that page 24 lines 2-6 discloses that computer 302 generates the token 316; and

reversed all 112, 2nd paragraph rejections of claims 32-70 noting that the "transmitting" and "generating" needed no antecedent basis.

The examiner has now made the follow objections and requirements to amend on basis that are tantamount to assertions that the claims failed to comply with 35 USC 112. The applicant treats these as rejections for purpose of appeal to obtain finality and repose in this application. The examiner stated that:

Claims 32, 44, 45, 57, 58 and 70 are objected to because of the following informalities-Concerning claim 32, there is a gap between the step of "transmitting said token data from said main computer to said personal computer over said computer network" and the step of "identifying said token data in a retail store in association with items being purchased at said retail store". Here, it is not clear how the token data are being associated with a consumer during a transaction or whether or not the token data are made available in a database for later retrieval or being printed on a piece of paper at the personal computer or encoded on a medium or a card and the consumer presents the printed paper or the card, having the token data imprinted or encoded thereon respectively, to effect a redemption at the retail store. In prosecuting the claims, the Examiner assumes, in one instance, that the token data (coupon selection information) are either printed on a piece of paper at a terminal or encoded on a card, which is presented at a checkout during a redemption and the printed paper or card is being referred here as a token. It is further assumed that the token or printed paper (receipt reminder) or card can be used as an identification means to identify the customer or consumer, at the retail store, to thereby retrieve the token data (coupon selection data) from a database, which stores the token data (coupon selection data) under the consumer's account. Claims 45 and 58 suffer from the same deficiencies and are objected to under a similar rationale.

Concerning claim 44, "...one of an intranet and the Internet" should apparently be --"...one of an intranet or the Internet--". Claims 57 and 70 suffer from the same deficiencies and are objected to under a similar rationale.

Appropriate corrections are required.

The examiner's assertion that "it is not clear how the token data are being associated with a consumer during a transaction" the applicant submits that that is not the function of claims. Claims define subject matter that is novel and non-obvious. The specification provides the enabling written description "how the token data are being associated with a consumer during a transaction". Accordingly, this rejection, stated in the form of an objection, is improper and should be reversed.

Regarding claims 44, 57, and 70's recitation ""...one of an intranet and the Internet", the applicant disagrees. The examiner argues that this recitation is unclear relying upon the assertion that an intranet is necessarily a portion of the Internet. That assertion is incorrect. An intranet may be a separate network, not part of the Internet. Moreover, the recitation in claims 44, 57, and 70, is in proper Markush format.

Finally, the examiner's requirements implying that claims 32 and 44, 57, and 70 are indefinite or lack support are contrary to the law of the case holdings noted above.

XII. 37 CFR 41.37(c)(viii) - Claims Appendix

A claims appendix is appendix 1.

XIII. 37 CFR 41.37(c)(ix) - Evidence Appendix

An evidence appendix is appendix 2.

XIV. 37 CFR 41.37(c)(x) - Related Proceedings Appendix

A related proceedings appendix is appendix 3.

5-20-2008

DATE

Respectfully Submitted,
/RichardNeifeld#35,299/

Richard Neifeld
Attorney of Record
Registration No. 35,299

BTM/ran

Printed: May 14, 2008 (5:01pm)

Y:\Clients\Catalina\CAT-29US-SCRO\CAT29US-SCROCO\Draft\SecondReplacementAppealBrief_CAT-29US-SCROCO_4-29-2008.wpd

APPENDIX 1 - CLAIMS APPENDIX OF APPEALED CLAIMS

1. - 31. (Canceled)

32. (Previously presented) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

33. (Previously presented) The method of claim 32, wherein generating said purchase incentive comprises generating an instantly redeemable voucher.

34. (Previously presented) The method of claim 32, wherein generating said purchase incentive comprises generating a voucher that is redeemable on a subsequent visit to said retail store.

35. (Original) The method of claim 32, further comprising generating a shopping list based on said selected product discounts.

36. (Original) The method of claim 35, further comprising transmitting said shopping list from said main computer to said personal computer over said computer network.

37. (Previously presented) The method of claim 32, wherein transmitting said

promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer.

38. (Previously presented) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified retailer.

39. (Previously presented) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer.

40. (Previously presented) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer.

41. (Previously presented) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of tokens by a consumer.

42. (Previously presented) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer.

43. (Previously presented) The method of claim 32, wherein identifying said token data comprises identifying said token data by scanning a token having said token data therein.

44. The method of claim 32, wherein said computer network comprises one of an intranet and the Internet.

45. (Original) A system for distributing purchasing incentives to consumers, comprising:

- a computer network;

- at least one personal computer;

- a main computer coupled to said at least one personal computer via said computer network and configured to transmit promotion data identifying a plurality of product discounts to said at least one personal computer over said computer network;

- said at least one personal computer configured to display said plurality of product

discounts based on said promotion data;

said at least one personal computer configured to transmit selection data designating at least one product discount selected from said plurality of product discounts to said main computer over said computer network;

said main computer configured to generate token data depending on said selection data; said main computer configured to transmit said token data to said at least one personal computer over said computer network;

a retail store configured to identify said token data in association with items being purchased at said retail store;

said retail store configured to determine discount items being purchased corresponding to said at least one product discount from said identified token data; and

said retail store configured to generate a purchase incentive based on said discount items.

46. (Original) The system of claim 45, wherein said retail store is configured to generate an instantly redeemable voucher as said purchase incentive.

47. (Original) The system of claim 45, wherein said retail store is configured to generate a voucher that is redeemable on a subsequent visit to said retail store as said purchase incentive.

48. (Original) The system of claim 45, wherein said main computer is configured to generate a shopping list based on said selected product discounts.

49. (Original) The system of claim 48, wherein said main computer is configured to transmit said shopping list to said at least one personal computer over said computer network.

50. (Original) The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts from a specified product manufacturer.

51. (Original) The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts from a specified retailer.

52. (Original) The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts from a specified product manufacturer and a specified product retailer.

53. (Original) The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts based on demographic data stored in a personal database of a consumer.

54. (Original) The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts based on a frequency of usage of tokens by a consumer.

55. (Original) The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts based on a frequency of usage of product discounts by a consumer.

56. (Original) The system of claim 45, wherein said retail store is configured to identify said token data by scanning a token having said token data therein.

57. (Original) The system of claim 45, wherein said computer network comprises one of an intranet and the Internet.

58. (Previously presented) A computer program product comprising a computer storage medium having a computer program therein for distributing purchasing incentives to consumers, said computer program performing:

- transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

- displaying said plurality of product discounts at said personal computer based on said promotion data;

- transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

 - generating token data depending on said selection data;

- transmitting said token data from said main computer to said personal computer over said computer network;

- identifying said token data in a retail store in association with items being purchased at said retail store;

 - determining discount items being purchased corresponding to said at least one product

discount from said identified token data; and

generating a purchase incentive based on said discount items.

59. (Previously presented) The computer program product of claim 58, wherein generating said purchase incentive comprises generating an instantly redeemable voucher.

60. (Previously presented) The computer program product of claim 58, wherein generating said purchase incentive comprises generating a voucher that is redeemable on a subsequent visit to said retail store.

61. (Original) The computer program product of claim 58, further comprising generating a shopping list based on said selected product discounts.

62. (Original) The computer program product of claim 58, further comprising transmitting said shopping list from said main computer to said personal computer over said computer network.

63. (Previously presented) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer.

64. (Previously presented) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified retailer.

65. (Previously presented) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer.

66. (Previously presented) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer.

67. (Previously presented) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of tokens by a consumer.

68. (Previously presented) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of

product discounts on a basis of a frequency of usage of product discounts by a consumer.

69. (Previously presented) The computer program product of claim 58, wherein identifying said token data comprises identifying said token data by scanning a token having said token data therein.

70. (Original) The computer program product of claim 58, wherein said computer network comprises one of an intranet and the Internet.

71. (Previously presented) The method of claim 32 wherein said personal computer is located remote from said main computer.

72. (Previously presented) The method of claim 32 wherein said personal computer is located outside said retail store.

73. (Previously presented) The method of claim 32 wherein said personal computer is located at a home of a user of said personal computer.

74. (Previously presented) The method of claim 32 further comprising logging said personal computer on to said a web site of said main computer prior to said transmitting promotion data.

75. (Previously presented) The system of claim 45 wherein said personal computer is located remote from said main computer.

76. (Previously presented) The system of claim 45 wherein said personal computer is capable of logging on to a web site of said main computer.

APPENDIX 2 - EVIDENCE APPENDIX

No evidence is submitted in support of the brief.

APPENDIX 3- RELATED PROCEEDINGS APPENDIX

The related proceedings appendix appears on the following pages.

BTM/ran

Printed: May 14, 2008 (5:01pm)

Y:\Clients\Catalina\CAT-29US-SCRO\CAT29US-SCROCO\Draft\SecondReplacementAppealBrief_CAT-29US-SCROCO_4-29-2008.wpd

United States Court of Appeals for the Federal Circuit

05-1370
(Serial No. 09/401,198)

IN RE MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND
(Real Party Interest Catalina Marketing Corporation)

JUDGMENT

ON APPEAL from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED-IN-PART AND REVERSED-IN-PART.

ENTERED BY ORDER OF THE COURT

DATED MAR 13 2006

Jan Horbaly
Jan Horbaly, Clerk

ISSUED AS A MANDATE: MAY - 4 2006

RECEIVED OCT 2006 - 582001-010508

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

NOTICE OF ENTRY OF JUDGMENT ACCOMPANIED BY OPINION

OPINION FILED AND JUDGMENT ENTERED: 03/13/06

The attached opinion announcing the judgment of the court in your case was filed and judgment was entered on the date indicated above. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and rehearing en banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

No costs were taxed in this appeal.

Regarding exhibits and visual aids: Your attention is directed to FRAP 34(g) which states that the clerk may destroy or dispose of the exhibits if counsel does not reclaim them within a reasonable time after the clerk gives notice to remove them. (The clerk deems a reasonable time to be 15 days from the date the final mandate is issued.)


JAN HORBALY
Clerk

cc: ROBERT G. CROCKETT
JOHN M. WHEALAN

IN RE SCROGGIE, 2005-1370
PTO - 09/401,198

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition
is not citable as precedent. It is a public record.

United States Court of Appeals for the Federal Circuit

05-1370
(Serial No. 09/401,198)

IN RE MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND
(Real Party Interest Catalina Marketing Corporation)

DECIDED: March 13, 2006

Before MAYER, RADER, and PROST, Circuit Judges.

Opinion for the court filed by Circuit Judge PROST. Opinion concurring-in-part and dissenting-in-part filed by Circuit Judge MAYER.

PROST, Circuit Judge.

Michael C. Scroggie, Michael E. Kacaba, David A. Rochon, and David M. Diamond (collectively, "Scroggie") appeal a decision by the United States Patent and Trademark Office Board of Patent Appeals and Interferences (the "Board") affirming the final rejection of claims 41-67 of U.S. Patent Application Serial No. 09/401,198 (the

"198 application") as obvious under 35 U.S.C. § 103 in view of a single prior art reference, U.S. Patent No. 5,933,811 ("Angles"). Ex parte Scroggie, Appeal No. 2004-0738, Paper No. 33 (B.P.A.I. Nov. 30, 2004) ("Board Decision"). Because the Board erred in construing the term "generating page data" in claims 41-49, we reverse the Board's decision with respect to those claims, but because the Board correctly construed the term "personalized web page" in claims 50-67, we affirm the Board's decision with respect to those claims.

BACKGROUND

On September 23, 1999, Scroggie filed the '198 application. The claims of the '198 application are generally directed to a system and method for generating a web page. In claims 41-49, "generating page data" is both a limitation of the claims and a part of the preamble, whereas for claims 50-67, "generating a web page" is only part of the preamble. Additionally, claims 50-67 contain the limitation "personalized web page." Claims 41 and 50 are representative with respect to each of those limitations which are the focus of the parties' dispute in this case.

41. A computer implemented method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer over a computer network;

transmitting personal information data from said personal computer to said main computer over said computer network in response to said prompt; and

generating page data defining a web page based upon said personal information data.

50. A computer method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer;

receiving at said main computer personal information data transmitted from said personal computer; and

transmitting from said main computer to said personal computer web page data for displaying a personalized web page, said personalized web page based upon said personal information data.

(emphases added).

The '198 application's specification, however, appears to be more narrow than its claims because it is generally directed to a method for sending shopping incentives (e.g., coupons) to customers over the internet. The coupons can be transmitted to the customer in various ways, including by e-mail and by embedding the coupons in a web page. The coupons can then be printed by the customer and used at retail stores.

In the decision on appeal, the Board relied solely on Angles as establishing a prima facie case of obviousness of claims 41-67.¹ In general, Angles discloses a system and method for delivering customized electronic advertisements in an interactive communication system. The Board found that the first two elements of representative claim 41, i.e., the two transmitting steps, were clearly taught or suggested by Angles. Scroggie does not disagree. Additionally, the Board found that the examiner had not explained where, in Angles, the third element, "generating page data defining a web page based upon said personal information data" was either taught or suggested. The Board, however, found that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyper-links to other information and that the "hyper-links typically direct the user's Internet browser to

¹ Additionally, the Board found that the examiner's rejection of claims 32-40 was improper because the examiner did not provide a convincing reason why the disclosure in Angles obviated the phrase "assigning a web page address to said web page based upon said personal information," as found in those claims. Therefore, the Board reversed the examiner's rejection with regard to claims 32-40 and therefore, Scroggie has not appealed the Board's decision with respect to those claims.

access different websites on the Internet." Board Decision, slip op. at 5. Thus, the Board concluded that since the advertisements sent to a consumer in Angles are based on personal information of the consumer and the hyper-links in the advertisement lead to a web page which is generated from some page data, "one may fairly interpret this disclosure as a teaching of 'generating page data defining a web page based upon said personal information.'" Board Decision, slip op. at 8.

In regard to claims 50-67, the Board found that the hyper-links in Angles suggest the "personalized web page" limitation because those hyper-links lead to a web page as a result of personal information. Thus, the Board concluded that the web pages displayed could be considered "personalized web pages" as that term is used in claims 50-67.

On Scroggie's request for rehearing, the Board reaffirmed its conclusion that Angles teaches the third limitation of claim 41, "generating page data defining a web page based upon said personal information." The Board reiterated that "if the advertisements, which are sent to a consumer based on personal information, are said to be 'page data' (i.e., the advertisement page contains data including a hyperlink) and the hyperlink (the hyperlink defining a web page since clicking on this hyperlink will send the user to that web page) in that page data is directed to a certain web page, it can be reasonably said that Angles generates page data defining a web page based on personal information, as claimed." Ex parte Scroggie, Appeal No. 2004-0738, Paper No. 33, slip op. at 3-4 (B.P.A.I. Feb. 10, 2005).

DISCUSSION

Obviousness is a legal question based on underlying factual findings. See e.g., In re Mayne, 104 F.3d 1339, 1341 (Fed. Cir. 1997). What a reference teaches, including whether it teaches toward or away from the claimed invention, is a question of fact. Para-Ordnance Mfg. v. SGS Imps. Int'l, 73 F.3d 1085, 1088 (Fed. Cir. 1995). This court upholds the Board's factual findings unless they are unsupported by substantial evidence. In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

Claim construction, however, is a question of law reviewed de novo on appeal. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc). Since during prosecution, claims must be given their "broadest reasonable interpretation," this court reviews the Board's interpretation of disputed claim language to determine whether it is "reasonable" in light of all the evidence before the Board. In re Hyatt, 211 F.3d 1367, 1372 (Fed. Cir. 2000); In re Morris, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

Scroggie contends that the Board incorrectly concluded that Angles teaches or suggests limitations defined by claims 41-67. He argues that a hyper-link is not a web page, but rather a logical address which is clearly known on the Internet. With respect to claims 41-49, he asserts that the inclusion of hyper-links in the advertisement sent to the consumer does not generate page data (i.e., result in page data being generated). Consequently, when a consumer clicks on the hyper-link, it does not result in "generating page data defining a web page based upon said personal information data," as recited in claim 41. This is so because the page data, contemplated by the hyper-links in the advertisements disclosed in Angles, already exist in the server computer

having the logical address specified in the hyper-link. Scroggie contends that "[w]hen the user clicks [on] the link in the advertisement, his computer sends a prompt to the corresponding address, and the computer at that address responds with a data file . . . [i.e., a web page], based upon data pre-existing at that computer." (Appellant's Br. 17.) Thus, Scroggie asserts that the Board erred in finding that Angles discloses this limitation because it does not teach or suggest "generating page data defining a web page based upon said personal information data."

The Director of the United States Patent and Trademark Office (the "Director") asserts that Angles teaches selecting custom advertisements to send to a consumer based on a consumer's personal information and that those custom advertisements can contain hyper-links. The Director argues that since the hyper-links are custom-selected and included in the electronic page that shows up on the user's screen, they are "page data." Also, since the hyper-links provide a direct link to a web page, they can reasonably be said to be "page data" that "define a web page" as required by the claims. Additionally, the Director argues that there is no limitation in the claim that prevents the customized page data from "preexisting," rather the only requirement of the claim is that it be customized for that consumer. Thus, when the disclosure in Angles teaches "selecting" customized advertisements which contain hyper-links to other web pages, this is sufficient to teach the "generating page data" element of claims 41-49.

We disagree. The term "generating page data" means that the page data is "generated," not merely "selected." Both the Board and the Director apply an unreasonable construction to the term "generating page data" such that Angles, which

teaches "selecting" advertisements which contain hyper-links can somehow teach or suggest "generating." Generating does not imply a mere selection of pre-existing page data, but rather the creation or origination of such data. Therefore, the Board's construction of "generating page data" was unreasonable and its conclusion that Angles teaches that limitation is thus unsupported by substantial evidence.

Additionally, in regard to independent claim 50, Scroggie argues that although "Angles' advertisement data may depend upon personal information stored at Angles' advertising provider computer. . . . Angles does not show . . . that data stored at some address specified in a hyper-link in an advertisement transmitted to Angles' consumer computer depends upon personal information [sic]." (Appellant's Br. 18.) Thus, Scroggie's argument focuses on the term "personalized web page" as used in claims 50-67.

The Director again argues that Scroggie is improperly reading a limitation into those claims because the term "personalized web page" can reasonably be construed to cover Angles's disclosure of custom-selected web pages which are accessed by clicking on the hyper-links within the advertisements that are sent to the consumer. Thus, the web page is "personalized" because it is custom-selected for the consumer based on personal information provided by the consumer.

We agree with the Director. The term "personalized web page" as used in claims 50-67 can reasonably be read to cover at least two types of personalization. One type of personalized web page is "personalized" because the contents of the web page transmitted to the consumer are themselves specific to the consumer. Another type of personalized web page is "personalized" because the web page itself, although not

necessarily specific to an individual consumer, was chosen to be transmitted, via a hyper-link, to that consumer based on the consumer's personal data. Because the term "personalized web page" can reasonably be construed to mean either type of "personalized," and because Angles discloses the latter type, Angles teaches this limitation of claims 50-67. Therefore, we will affirm the Board's decision with respect to those claims.

CONCLUSION

Because we find that the Board's construction of the term "generating page data" was unreasonably broad, we find that Angles does not teach or suggest "generating page data" as used in claims 41-49. Additionally, because we find that the Board's construction of the term "personalized" in claims 50-67 was not unreasonable, the Board's finding that Angles teaches or suggests the "personalized web page" limitation in those claims is supported by substantial evidence. Accordingly, we reverse the Board's decision with respect to claims 41-49, and affirm the Board's decision with respect to claims 50-67.

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record.

United States Court of Appeals for the Federal Circuit

05-1370
(Serial No. 09/401,198)

IN RE MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND
(Real Party In Interest Catalina Marketing Corporation)

MAYER, Circuit Judge, concurring-in-part and dissenting-in-part.

I agree that the decision of the Board of Patent Appeals and Interferences, Ex parte Scroggie, Appeal No. 2004-0738, Paper No. 33, at 5-6 (B.P.A.I. Nov. 30, 2004) ("Board Decision"), should be affirmed with respect to claims 50-67 of U.S. Patent Application Serial No. 09/401,198 ("the '198 application"). However, because we review the board's interpretation of disputed claim language to determine whether it was reasonable in light of the evidence before the board, see, e.g., In re Hyatt, 211 F.3d 1367, 1372 (Fed Cir. 2000), and because we review the factual findings underlying the board's obviousness determination for substantial evidence, I would also affirm the board's finding that claims 41-49 are obvious in light of Angles.

Because the advertisements sent to a consumer in Angles are based on the user's personal information and the advertisement hyperlinks "lead to a web page which is generated from some page data[.]" Board Decision, at 5-6, the board found that one may interpret Angles as teaching the third limitation in claim 41, "generating page data defining a web page based upon said personal information data." In Angles, hyperlinks are custom-selected for inclusion on an electronic page that shows up on the user's screen and can, therefore, reasonably be called "page data." The determination that the hyperlinks in Angles are "page data [that] defin[e] a web page" was reasonable because the hyperlinks, which can link a user to a web page, are custom-selected and included on the electronic page that shows up on a user's screen.

Finally, the board's construction of the term "generating," though broad, was not unreasonable. There is no limitation in the '198 application that prevents the term "generating" from being interpreted to allow preexisting customized page data, so long as the page data that is "generated" for the consumer is based on his specific user information, as done in Angles.

8-19-04
28

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

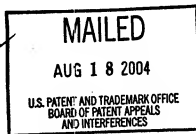
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA, ✓
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-1420 ✓
Application No. 09/567,274 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the twice-rejected claims 28-43.¹

¹The statement of the 35 U.S.C. § 103 rejection in both the answer and in Paper No. 19 indicates that the claims subject to this rejection are claims "34-43" with no indication that claims 28-33 have been rejected on this ground. However, since the body of the rejection in both the answer and in Paper No. 19 then goes on to indicate why claims 28-33 are rejected under 35 U.S.C. § 103, and appellants, by their arguments, clearly understand all

Dec App CMT29SCROD3-040819 es

The invention relates to providing shopping incentives to customers through a computer network.

Representative of the sixteen independent claims is claim 28, reproduced as follows:

28. A method for distributing purchasing incentives to retail consumers over a computer network, said method comprising the steps of:

storing product purchase data pertaining to products purchased in association with an identification in a consumer purchase history database;

storing an electronic mail address in association with said identification in a consumer electronic address database;

generating a purchase incentive in response to said identification being provided over said computer network, based on said product purchase data and depending upon frequency of prior use of purchase incentives generated for said identification; and

transmitting said purchase incentive to said electronic mail address.

The examiner relies on the following reference:

Barnett et al. (Barnett) 6,336,099 Jan. 1, 2002
(eff. filing date of Apr. 19, 1995)

of claims 28-43 to stand rejected under 35 U.S.C. § 103, we will treat claims 28-43 as standing twice rejected under 35 U.S.C. § 103 and on appeal herein.

Claims 28-43 stand rejected under 35 U.S.C. § 103 as unpatentable over Barnett.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

It is the examiner's position, with regard to instant claims 34, 35, 38 and 39, that Figure 1 of Barnett is indicative of a system for distributing purchasing incentives to retail customers over a computer network wherein a database is configured to store product purchase data pertaining to products purchased in association with an identification in a consumer purchase history

database; and that Figure 9 and column 9, lines 59-67, teach a generation of an incentive based upon whether a signal containing the identification was received in a selected prior time period.

The examiner also indicates that Barnett teaches the storing of an electronic mail address in association with said identification in a consumer electronic database at column 13, lines 58-67. However, the examiner indicates that Barnett does not specifically teach transmitting the incentives to the electronic mail address. But, since "the e-mail address for the user is stored...it would have been obvious...to have included transmitting incentives to the user's electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user (col. 4, lines 25-29)" (answer-page 3).

Specifically, with regard to claims 28, 29, 32, 33, 40 and 41, the examiner finds that purchase incentives generated based upon frequency of redemption of online purchase incentives generated for said identification (see page 4 of the answer) would have been obvious in view of Barnett's disclosure at (Figures 1-9 and column 7, lines 35-55).

The examiner cites Figure 9 of Barnett as evidence of the obviousness of the limitations of claims 30 and 31 and the

examiner cites Figures 1 and 9 of Barnett as evidence of the obviousness of the limitations of claims 36, 37, 42 and 43.

Appellants' position, with regard to claims 28, 29, 32 and 33 is that Figures 1-9 and column 7, lines 35-55 of Barnett do not disclose the claimed "generating said purchase incentive...based upon frequency of prior use of purchase incentives generated for said identification."

With regard to claims 30 and 31, appellants argue that Figure 9 of Barnett does not disclose the claimed "generating said purchase incentive for said identification based upon a frequency of prior use of an online system with said identification."

With regard to claims 34 and 35, appellants argue that Figure 9 of Barnett, column 6, lines 62-66, which describes this figure, and column 9, lines 59-67, do not disclose "generating an incentive based upon whether a signal containing said identification was received in a selected prior time period..."

With regard to claims 36 and 37, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive based on said product purchase data including whether said identification is associated with redemption of an online purchase incentive during a selected prior time period..."

With regard to claims 38 and 39, appellants argue that Figure 9 and column 9, lines 59-67, of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network, based at least in part upon frequency of selection of purchase incentives generated for said identification."

With regard to claims 40 and 41, appellants argue that Barnett does not disclose the concept of generating a purchase incentive at least in part on frequency of redemptions of online purchases generated for an identification.

With regard to claims 42 and 43, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network and based at least in part upon whether said identification is associated with selection of an online purchase incentive during a selected prior time period..."

With regard to all of the claims, 28-43, appellants argue that column 13, lines 58-67, of Barnett, does not disclose "storing an electronic mail address in association with said identification in a consumer electronic database." It is appellants' view that it would not have been obvious to store an electronic mail address in association with said identification

in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

We AFFIRM.

It appears to us that the examiner has set forth a reasonable case, identifying claim limitations and pointing out where, in the reference, such limitations can be found or why the claimed subject matter would have been obvious in view of specific teachings of Barnett. Thus, we find that the examiner has established a prima facie case of obviousness.

Yet, appellants' main response is that Barnett "does not disclose" some limitation quoted from the claims. However, appellants do not explain why they take these positions in view of the examiner's rationale. It is not enough for appellants to merely state that the reference does not disclose something when the examiner has pointed out where and how the reference is considered to have disclosed something or to have made that something obvious. 37 CFR 1.192(c)(8)(iv) requires appellants' arguments to "specify the errors in the rejection and, if

appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art" (emphasis added).

Appellants get somewhat specific with regard to the storing of an electronic mail address in association with said identification in a consumer electronic database by arguing that it would not have been obvious to store an electronic mail address in association with said identification in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

However, we agree with the examiner that while Barnett may not specifically teach the claimed storing of an electronic mail address in association with said identification in a consumer electronic database, it would have been obvious to do so. This is so because Barnett clearly teaches storing a user's e-mail Internet address (column 13, lines 62-65) and since the online

system maintains the user's e-mail Internet address, it would have been clearly obvious to associate a particular user with his/her particular e-mail address and to use such address for any desired transmission to a user.

We note that appellants do not address the obviousness of providing for the claimed storing of an electronic mail address in association with said identification in a consumer electronic database. They merely argue that the reference does not disclose this. It should be noted that this is not an anticipation rejection based on 35 U.S.C. 102, but rather an obviousness rejection based on 35 U.S.C. § 103. Accordingly, the mere allegation by appellants that the applied reference does not disclose a particular claim limitation is not dispositive of the issue of obviousness. Appellants must explain, in view of the examiner's reasonable rationale, why the claimed subject matter would not have been obvious, i.e., appellants must point out the alleged errors in the rejection. This, appellants have not done.

In the reply brief, appellants get more specific regarding the argument that the reference does not disclose the "frequency" limitation. That is, in reviewing column 7, lines 35-55, of Barnett, appellants argue that while the coupon distribution center 16 utilizes the user-specific redemption data, along with

user-specific demographic data supplied by the online service provider 2, this passage does not disclose generating a purchase incentive based at least in part upon frequency of use or redemption of incentives.

We agree with appellants that Barnett does not specifically disclose generating the incentive based at least in part upon frequency of use or redemption. But, again, the rejection is based on obviousness under 35 U.S.C. § 103, rather than anticipation. The reference does not need to specifically disclose the generation of incentives based at least in part upon frequency of use or redemption, as long as there is some suggestion to do so or something that would have led the artisan to base the incentive generation at least in part upon frequency of use or redemption.

The cited portion of column 7 of Barnett makes it clear that distribution of user-specific data to the coupon distribution center is of value and that such data is used for marketing analysis so that subsequent coupon packages may be targeted specifically at certain users. The reference also makes it clear thereat that the coupon distribution center utilizes the user-specific redemption data along with the user-specific demographic

data supplied by an online service provider in order to compile subsequent coupon data.

It appears to us that the artisan would have recognized that frequency of use or redemption is part of the user-specific data and/or user-specific redemption data taught by Barnett. Users who employ coupons more frequently are more likely to be targets to whom coupons will be offered and the coupon issuer would be very interested in this statistic in determining whom to target. Therefore, the artisan would have found it obvious, in view of Barnett's disclosure, to base the generation of incentives at least in part, upon frequency of use or redemption of such incentives.

Appellants have offered nothing to show error in such rationale because appellants do not attack the obviousness of generating incentives based at least in part upon frequency of use or redemption; they merely state that Barnett does not disclose this.


Accordingly, appellants' arguments are not persuasive of unobviousness and fail to overcome the prima facie case of obviousness established by the examiner.

The examiner's decision rejecting claims 28-43 under 35 U.S.C. § 103 is affirmed.

Appeal No. 2004-1420
Application No. 09/567,274


No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


ERROL A. KRASS)
Administrative Patent Judge)

Jerry Smith
JERRY SMITH
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES


MICHAEL R. FLEMING
Administrative Patent Judge

EK/RWK

Appeal No. 2004-1420
Application No. 09/567,274

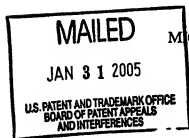
NEIFELD IP LAW, PC
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MICHAEL C. SCROGGIE,
MICHAEL E. KACABA, DAVID A. ROCHON
and
DAVID M. DIAMOND

Appeal No. 2004-1420
Application No. 09/567,274 CAT/29-SCRO-CO3

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we rehear, and reconsider, our decision of August 18, 2004,
wherein we sustained the examiner's rejection of claims 28-43 under 35 U.S.C. §103.

In particular, appellants contend that we assumed facts not in evidence as the basis for our conclusion that the examiner had established a prima facie case of obviousness. Moreover, appellants argue that although the examiner has provided no reason as to why the claimed subject matter would have been obvious, our decision merely points to the fact that appellants have not traversed the non-existent reasoning of the examiner, specifically pointing to page 8, line 17, through page 9, line 7 of our decision (see page 5 of the request for rehearing).

Moreover, appellants argue, the examiner did not point out where and how the Barnett reference made the claimed subject matter obvious and, in fact, the examiner's assertions were only sufficient to support an allegation of anticipation, not obviousness (page 5 of the request for rehearing).

We disagree with appellants.

First, it is clear, from page 3 of the answer that the examiner's reasons for rejection of the claims were based on obviousness, and not anticipation. Note that at that portion of the answer, after indicating that Barnett discloses various claimed elements, and where those disclosures may be found within Barnett, the examiner indicates that Barnett "does not specifically teach

transmitting the incentives. . . .” The examiner then goes on to state why the claimed subject matter as a whole would have been obvious, by stating that

[s]ince the e-mail address for the user is stored then it would have been obvious . . . to have included transmitting incentives to the user’s electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user.

While the examiner specifically applied this reasoning to claims 34-43, it is clear that this reasoning is applicable to the other claims since those other claims also include the limitation of transmitting a purchase incentive to an electronic mail address.

Further, while the examiner may not have gone into as much detail as appellants desired in applying Barnett to the specifics of the claims, the examiner did, in fact, set forth a reasonable case of obviousness by indicating how each of the claimed elements is alleged to have been taught by Barnett and why the claimed subject matter would have been obvious thereover. Accordingly, the burden shifted to appellants to overcome the examiner’s prima facie case by specifically pointing to some error in the examiner’s reasoning.

Yet, instead of pointing specifically to error in the examiner’s reasoning and showing how/why Barnett does not teach what is alleged by the examiner, appellants merely cite portions

of the claims and cavalierly contend that Barnett "does not disclose or suggest" the claimed subject matter (e.g., see paragraph d at page 7 of the principal brief) without further explanation.

When confronted with a rejection under 35 U.S.C. §103, an applicant is obliged to specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection. Moreover, the applicant should explain how such limitations render the claimed subject matter unobvious over the prior art. In the instant case, appellants have failed to explain how the cited claim limitations render the claimed subject matter unobvious. It is true that the examiner has the burden, in the first instance, to establish a prima facie case, but, once that case is established, as we hold it was here, appellants must come forward with specific arguments as to why the examiner's rationale is erroneous and why the specific claim limitations render the claimed subject matter unobvious. For the most part, appellants have not done this.

We note that arguments that appellants could have made but, for whatever reason, have not made, are waived. In re Kroekel, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986).

At page 6 of the request for rehearing, appellants argue that the claim limitation of "generating said purchase incentive based upon frequency of prior use of purchase incentives

generated for said identification" is not taught by Barnett. In particular, appellants argue that Barnett teaches what is stored in the database 11 and those stored elements do not include a time of prior use of a purchase incentive generated for identification.

While appellants are arguing that the "frequency of use" limitation of some of the claims is not taught by Barnett, as we said in our decision, the rejection is not one based on anticipation, but, rather, on obviousness. Therefore, the applied reference need not teach each and every element, including "frequency of use." It is only necessary that the applied reference suggests the claimed subject matter so that the artisan would have been led, from its teaching, to base the incentive generation at least in part upon frequency of use.

As we indicated in our decision at pages 11 and 12:

The cited portion of column 7 of Barnett makes it clear that distribution of user-specific data to the coupon distribution center is of value and that such data is used for marketing analysis so that subsequent coupon packages may be targeted specifically at certain users. The reference also makes it clear thereat that the coupon distribution center utilizes the user-specific redemption data along with the user-specific demographic data supplied by an online service provider in order to compile subsequent coupon data.

It appears to us that the artisan would have recognized that frequency of use or redemption is part of the user-specific data and/or user-specific redemption data taught by Barnett. Users who employ coupons more

frequently are more likely to be targets to whom coupons will be offered and the coupon issuer would be very interested in this statistic in determining whom to target. Therefore, the artisan would have found it obvious, in view of Barnett's disclosure, to base the generation of incentives at least in part, upon frequency of use or redemption of such incentives.

Appellants have offered nothing to show error in such rationale because appellants do not attack the obviousness of generating incentives based at least in part upon frequency of use or redemption; they merely state that Barnett does not disclose this.

Accordingly, we did explain in our decision why the artisan would have been led to the instant claimed subject matter and appellants have not convinced us of any error in our decision.

While appellants now argue that Barnett's teaching of periodic downloading and frequency is the inverse of periodicity, that we misapprehended the examiner's position regarding a "selected time period" and that we rely on facts not in evidence, such as "[u]sers who employ coupons more frequently are more likely to be targets to whom coupons will be offered," appellants do not appear to point to any perceived error in our rationale for sustaining the rejections. That is, while appellants argue that we rely on facts not in evidence, appellants do not refute the allegation that "[u]sers who employ coupons more frequently are more likely to be targets to whom coupons will be offered." Further, even if, arguendo, we may have applied the

reference in a somewhat different manner than did the examiner, appellants have not convincingly shown any error in our application of the reference.

Accordingly, since, in our view, appellants have not shown any error in our decision, while we grant appellants' request for rehearing to the extent that we have reconsidered our decision, we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED


ERROL A. KRASS
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

EAK:psb

Appeal No. 2004-1420
Application 09/567,274

Neifeld IP Law, PC
2001 Jefferson Davis Highway
Arlington, VA 22202

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

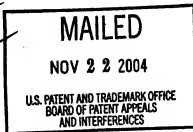
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Atty Review: 12-9-04

Ex parte MICHAEL C. SCOGGIE, MICHAEL E. KACABA, ✓
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0989 ✓
Application No. 09/401,939 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-70.

The invention is directed to providing shopping aids and incentives to customers through a computer network. In particular, purchasing incentives are distributed to a consumer by transmitting promotion data identifying a plurality of product

discounts from a main computer to the consumer's computer and displaying the plurality of product discounts at the consumer's computer based on the promotion data. Selection data designating at least one product discount selected from the plurality of product discounts is then transmitted from the consumer's computer to the main computer.

Representative independent claim 32 is reproduced as follows:

32. A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

The examiner relies on the following references:

Day et al. (Day)	5,857,175	Jan. 5, 1999
Scroggie et al. (Scroggie)	5,970,469	Oct. 19, 1999 (filed Mar. 26, 1996)

Claims 32-70 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as relying on a disclosure lacking enablement and a written description, and as being vague and indefinite.

Claims 32-70 stand further rejected under 35 U.S.C. § 102(b) as anticipated by Day.

Claims 32-70 stand further rejected under 35 U.S.C. § 103 as "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike" (answer-page 5).

Claims 32-70 stand still further rejected under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469 to Scroggie.

Claims 32-70 stand even still further rejected under 35 U.S.C. § 103 "over copending US Patent Application 09/567,274" (answer-page 8).¹

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

We turn, first, to the rejection of claims 32-70 under 35 U.S.C. § 112, first paragraph.

The examiner contends that the claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are "not enabled by the specification." The examiner also contends that the inventors did not have possession of the claimed invention at the time of filing because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to

¹While the examiner indicates the rejection is based on "prior art" in stating that the rejection is under "35 U.S.C. § 103, it is clear from the examiner's explanation, especially, at the bottom of page 15 in the answer, that the rejection is really a provisional rejection based on obviousness-type double patenting.

a main computer over a computer network and generating token data depending on selection data.

It is the examiner's position that these claimed features are not enabled by the instant specification since the "examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention" such that skilled artisans could make and use the invention.

The examiner's position regarding the rejection of the claims under 35 U.S.C. § 112, first paragraph, is unreasonable and we will not sustain these rejections.

As a matter of Patent and Trademark Office practice, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of 35 U.S.C. 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the teaching

contained in the specification is truly enabling, In re Marzucchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971); In re Sichert, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977).

When a rejection is made on the basis that the disclosure lacks enablement, it is incumbent upon the examiner to explain why he doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions with acceptable evidence or reasoning which is inconsistent with the contested statement. The examiner has not advanced any such evidence or an acceptable line of reasoning inconsistent with enablement and, therefore, has not sustained his burden.

Not only has the examiner not set forth any reasonable basis for challenging the sufficiency of disclosure, asserting, without explanation, that he deems the claimed features to be merely "concepts that cannot be practically applied" (answer-page 4), but it appears to us that the claimed features of "transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network" and "generating token data depending on said selection data" merely entail programming web sites to provide the functionality claimed. This functionality of transmitting data selected from a plurality of

choices and generating other data in dependence on the selection data does not appear to us to be anything out of the ordinary for the skilled web programmer and would not entail any undue experimentation on his/her part.

Accordingly, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, first paragraph, based on non-enablement.

With regard to written description, we also will not sustain the rejection of claims 32-70 on this ground.

The examiner again points to the claim language, "transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network" and "generating token data depending on said selection data" and, now, alleges that since the specification does not discuss these claimed features, it is not considered that the applicants had possession of what they now claim as their invention at the time of filing the instant application.

Appellants point to page 9, lines 4-5, of the instant specification for a disclosure of a customer selecting a coupon offer from a plurality of offers after log-in and switching to an offer browser.

With regard to "generating token data...", appellants point to page 24, lines 2-6, of the specification. Since this portion of the specification states that

Generating a "token" instead of coupon, as described above with reference to FIG. 13, also reduces the risk of fraud. Another technique similar to this is depicted in FIG. 18. A token 316 is generated by the user's computer 302 after interaction with the distribution server 300. The user chooses from incentive offers as described above, but instead of a coupon the computer 302 generates the token 316,

it is clear to us that applicants did, indeed, have possession of the invention which they now claim.

Thus, we will not sustain the rejection of claims 32-70 under the written description clause of 35 U.S.C. § 112, first paragraph.

Turning to the rejection of the claims under 35 U.S.C. § 112, second paragraph, the examiner alleges that the claims are indefinite because there is no antecedent basis for "transmitting selected data" or "generating token data" in the claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network and generating token data depending on said selection data. The examiner also alleges that the instant specification also does

not provide an antecedent basis for these claim limitations.

First, we point out that the second paragraph of 35 U.S.C. § 112 is directed to the claims, not the specification. We may look to the specification to give meaning to an otherwise misunderstood claim limitation but the claims themselves must provide the antecedent basis for the specific claimed steps/elements.

Moreover, the inquiry under 35 U.S.C. 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In the instant case, taking claim 32 as exemplary, the steps of "transmitting selection data..." and "generating a token data..." are first time recitations within the claim and the recited steps themselves provide the antecedent basis for the steps. Thus, the examiner's concern for "antecedent basis" is not understood. It is not as if the claims recited "said step of

transmitting selection data..." and never previously recited such data.

Accordingly, we find that the examiner's rejection under 35 U.S.C. § 112, second paragraph, has no basis, in fact. The claims do set out and circumscribe a particular area with a reasonable degree of precision and particularity and, as such, are in accordance with 35 U.S.C. § 112, second paragraph. The examiner has failed to reasonably show any indefiniteness within the claims.

Thus, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, second paragraph.

The examiner's next rejection deals with anticipation of the claims under 35 U.S.C. § 102(b) over Day.

A claim is anticipated only when a single prior art reference expressly or inherently discloses each and every element or step thereof. Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). If the examiner presents a reasonable basis for alleging inherency, the burden shifts to appellant to come forward, if they can, with evidence to the contrary. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Ludtke, 441

F.2d 660, 169 USPQ 563 (CCPA 1971); In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

It is the examiner's position that claims 32-70 are "clearly anticipated" by Day, without any explanation in the statement of the rejection at page 5 of the answer.

In response to appellants' arguments, the examiner explains his position, at pages 11-14 of the answer. That position is that column 1, line 64 through column 2, line 5, and column 3, line 20, anticipates all of the claimed subject matter with regard to the independent claims.

The examiner basically relies on the background section of Day, wherein is described an in-store terminal which a consumer may access. A list of coupons is presented to the consumer, and a link between the terminal and check-out stations in the store permits discounts selected by the consumer to be subtracted from the total bill on check-out.

We would agree that, given the broadest, reasonable interpretation of "personal computer," "computer network" and "main computer," one might consider the in-store terminal described in Day as a "personal computer" since it is used by the consumer. One may even consider the link between the terminal and the check-out stations to be part of a "computer network."

Possibly, the main check-out stations might constitute the claimed "main computer."

However, it is not clear from the description in Day, or from the examiner's explanation, that the main computers (i.e., the main check-out stations) are actually transferring the promotion data to the personal computer (i.e., the consumer terminals). The instant claims require the main computer to transfer promotion data identifying a plurality of product discounts to a personal computer over a computer network.

But, even if we assume that the check-out stations described in the cited portions of Day do, in fact, transmit the promotion data to the customer terminal and even if we assume, then, that Day would teach the claimed steps of "transmitting promotion data...", "displaying said plurality of product discounts..." and "transmitting selection data...", the examiner's case would still fail because the instant claims all require an element/step of "generating token data depending on said selection data."

The examiner's rationale is that this generation of token data is "considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the

disclosed discount subtraction" (answer-page 12), referring to lines 3-4 of column 2 in Day.

The cited portion of Day refers to "discounts selected by the consumer." This may be equivalent to the claimed "...at least one product discount selected..." in the "transmitting selection data..." paragraph of claim 32, for example. But, this cited portion of Day cannot then also serve as disclosing the next claimed step of "generating token data depending on said selection data" because it is only after the selection is made that a token, depending on said selection data, can be generated.

Moreover, we do not see how the generation of such token data can be "implicit" as urged by the examiner.

The examiner has pointed to nothing in the Day disclosure which even suggests the claimed generation of "token data." Without a teaching of this token data, Day cannot identify any such token data or determine discount items being purchased from undisclosed token data.

Accordingly, since the examiner's rationale fails to convincingly point, in the applied reference, to the claimed "token data," the examiner has failed to establish a prima facie case of anticipation and we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 102(b).

We do point out, in passing, however, that should the examiner have convinced us of a teaching of such "token data" in Day, appellants' arguments would have been insufficient to overcome such a prima facie case since appellants merely argue that Day does not disclose what is recited in the claims, without specifically pointing out any perceived errors in the examiner's position, and without specifically identifying particular claimed features which are considered to distinguish over Day.

Nevertheless, since the burden to establish a prima facie case of anticipation rests initially on the examiner, and, in our view, the examiner clearly failed to meet that burden in this case, we do not reach appellants' arguments.

The examiner's next rejection, under 35 U.S.C. § 103, is based on "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike."

The examiner contends that since "at least 1994, PerformanceBike has performed the claimed method, system and program..." The examiner states that he

has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token

use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased... The claimed invention...has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known...to claim the invention as recited by the applicant by substituting terms with patentably equivalent claim language, in order to overcome the explicit teachings of the examiner's experienced prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious...to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known... It is considered that the claim recitations using "computer" are an attempt to automate an old and well known process provided by PerformanceBike... (answer-pages 6-7).

Appellants argue, at pages 15-20 of the principal brief, that the PerformanceBike website has not been established as

prior art and the examiner has offered no physical evidence to support the examiner's assertions.

We have considered the examiner's assertions and appellants' arguments thereagainst and we conclude that the examiner has simply not established that his experience with PerformanceBike would constitute a prima facie case of obviousness against the instant claimed subject matter. Without physical evidence and/or a more detailed written description as to how the PerformanceBike retail system works, we are not persuaded by the examiner's declaration of experience that the frequent buyer card bar code number would read on the generating, transmitting and identifying steps in paragraphs 5-7, for example, of claim 32, or that a red courtesy phone may be considered the claimed "personal computer." We are also not convinced that the claimed transmitting promotion data would be met by merely walking into a PerformanceBike retail store so that the information is "transmitted" to the consumer.

Since the examiner's experience is not convincing as to obviousness of the instant claimed subject matter, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 103 based on the examiner's experience with PerformanceBike.

The examiner also rejected claims 32-70 under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

As the examiner explained, at page 8 of the answer, while the claims are not identical, they are not patentably distinct from each other because "the patented feature of encoded data is an obvious variation of the application claimed token and because both perform the same function in the same manner with the same result."

It is our view that the examiner makes at least a reasonable case since the "token" of the instant claims does appear to be similar to the patented "purchasing incentive containing in encoded form the identity of the retailer designated by the customer..." In the face of this rather reasonable finding of obvious-type double patenting, appellants' sole argument is that the patented claims

define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives. One would not have been obvious in view of the other (principal brief-page 22).

Thus, appellants merely assert that the instant claims would not have been obvious over the patented claims but do not point to any error in the examiner's reasoning. It is not enough to

argue that the instant claims define identifying token data in a retail store when the patented claims are also clearly directed to generating purchase incentives for a retail store. Appellants have offered nothing to show any non-obviousness difference between the claimed "token" and the encoded purchasing incentive, while the examiner has made out a reasonable case that one would have been obvious over the other.

Accordingly, we will sustain the rejection of claims 32-70 over obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

Finally, we turn to the examiner's rejection of the claims "under 35 U.S.C. § 103(a) as being obvious over copending US Patent Application 09/567,274," which, as explained supra, is really a provisional rejection based on obviousness-type double patenting.

It appears to be the examiner's position that the difference between the instant claims and the claims in the copending application is in the recitation, by the latter, of the generation of redeemable vouchers, separate shopping list transmission, etc. and that the instant claims would have been obvious thereover, especially since the instant claims appear to be broader in scope.

The examiner's position does not appear to be unreasonable. Yet, appellants do not dispute the merits of the rejection. Instead, they argue only that the copending application is not prior art because it "appears from the PTO website to be unpublished" (principal brief-page 24). Appellants appear to be responding to a rejection thought to be under 35 U.S.C. § 103. However, the examiner made it clear, in the response section of the answer, that this rejection was really a provisional obviousness-type double patenting rejection. In filing a reply brief, appellants had an opportunity to respond to this rejection but, for whatever reason, chose not to do so. Thus, in effect, we have no response from appellants with regard to the rejection.

If the copending application has been, or will be, abandoned, then this rejection becomes moot. However, if the copending application remains pending with the claim language identified by the examiner, then this "provisional" rejection appears to us to be proper.

Accordingly, we will sustain this provisional rejection of claims 32-70 over copending application Serial No. 09/567,274, based on obviousness-type double patenting, as appellants have convinced us of no error in the examiner's position.

Rejections which were previously made by the examiner but not repeated in the answer are not before us. Accordingly, contrary to appellants' request, we will not treat such rejections.

CONCLUSION

We have not sustained the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs. We also have not sustained the rejection of claims 32-70 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103 based on an obvious variation of the examiner's personal knowledge of incentives by PerformanceBike.

We have, however, sustained the rejection of claims 32-70 based on obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469, and over claims of copending application Serial No. 09/567,274.

Therefore, the examiner's decision is affirmed.


Appeal No. 2004-0989
Application No. 09/401,939

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Errol A. Krass
ERROL A. KRASS
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

EK/RWK

Appeal No. 2004-0989
Application No. 09/401,939

NEIFELD IP LAW, PC
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

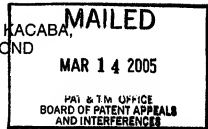
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCOGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

CAT/29US-SCROCO

Appeal No. 2004-0989
Application No. 09/401,939



ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants filed a request for rehearing under 37 CFR § 41.52, on January 24, 2005, requesting that we reconsider our decision of November 22, 2004 wherein we sustained the rejection of claims 32-70 based on obviousness-type double patenting. We presume that appellants do not take issue with that part of our decision wherein we did not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103.

Dec Rehear-CAT29USSCROCO-050316

As an initial matter, appellants contend that we are not authorized by 37 CFR § 41.50 to "sustain" or "not sustain" but only to "affirm" or "reverse."

In our view, "affirm" is synonymous with "sustain" and "reverse" is synonymous with "not sustain." While our final decision is to affirm, reverse, or affirm-in-part, the decision of an examiner, sometimes we will state that individual rejections, comprising the examiner's decision, are "sustained" or "not sustained." In any event, this "argument" by appellants is superfluous as it has no bearing on the merits of our decision or, for that matter, on anything else.

On more important matters, appellants contend that with respect to the rejection of claims 32-70 over related case 09/567,294, we overlooked the fact that the examiner presented a new ground of rejection in the answer, which the examiner was not permitted to do under 37 CFR § 1.193, in effect at the time of the answer. Appellants' position is that the examiner's answer, for the first time, presented the rejection as one of provisional obviousness-type double patenting over application Serial No. 09/567,274, in contrast to the final rejection which rejected these claims under 35 U.S.C. §103 as unpatentable over the claims of application Serial No. 09/567,274.

While we have considered appellants' argument, we find no actionable error in our decision. It is true that the examiner based the rejection in issue on "35 U.S.C. §103," but it is also clear from the answer, at page 8, that the examiner was really basing the rejection on "double patenting," as the rejection is listed under that heading. In any event, the rationale has been the same throughout the prosecution (viz., in the

final rejection and in the answer) that the instant claims were not patentably distinguishable from the claims of copending application Serial No. 09/567,274. Moreover, if appellants thought that the examiner was establishing an impermissible new ground of rejection, in the answer, appellants could have, and, in fact, did, file a reply brief. Therefore, we fail to see how appellants have been harmed by the examiner's possible error of using "35 U.S.C. §103" in the statement of the rejection. Yet, even though appellants filed a reply brief and, by then, it was clear, or should have been clear, to appellants what the examiner's position was regarding the provisional obviousness-type double patenting rejection, appellants chose, for whatever reason, not to respond to this rejection.

Accordingly, since we find that appellants have shown no actionable error in our decision, while we grant appellants' request to the extent that we have reconsidered our decision, the request is denied with respect to making any changes therein.

12-27-04
DB
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

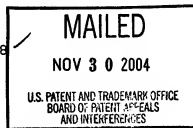
Atty Review: 12-7-04

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA, ✓
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738 ✓
Application No. 09/401,198 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-67.

The invention is directed to providing shopping aids to customers through a computer network. In particular, a prompt for personal information from a main computer to a personal computer is transmitted over a network; personal information data

Dec-CAT29USSCRODI-041202 KB BMR

is transmitted over the network from the personal computer to the main computer responsive to the prompt; page data defining a web page based on the personal information is generated; and a web page address to that web page is assigned.

Representative independent claim 32 is reproduced as follows:

32. A computer implemented method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer over a computer network;

transmitting personal information data from said personal computer to said main computer over said computer network in response to said prompt;

generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information.

The examiner relies on the following reference:

Angles et al. (Angles)	5,933,811	Aug. 3, 1999 (filed Aug. 20, 1996)
------------------------	-----------	---------------------------------------

Claims 32-67 stand rejected under 35 U.S.C. § 103 as unpatentable over Angles.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

The examiner points to Figures 1-3, 7, and 9-11, and column 5, lines 62-67, column 6, lines 4-14, column 7, lines 19-42 and column 8, lines 10-19 and 33-67, of Angles and alleges that while these cited portions of the reference lack "explicit" recitation of all of the elements of the claim, e.g., independent claim 32, it would have been obvious to arrive at the instant claimed subject matter

because such a method supports customization "which can contain hyper-links to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet...In addition, to executing the content provider script, the advertisement provider also obtains the consumer's member code from the consumer computer. The advertisement provider uses the consumer's member code to identify the consumer's demographic profile and preferences..." (See Angles (col. 4, ll. 6-14; and col. 3, ll. 53-65)). (Answer-pages 6-7).

We will sustain the rejection of claims 41-67 under 35 U.S.C. § 103 because the examiner has established a prima facie case of obviousness. We will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 because, in our view, the examiner has not established such a case with regard to the subject matter of these claims.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must not only identify the elements in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the instant case, the examiner merely alleges that each and every claim limitation is either taught or suggested by Angles or that the claimed subject matter would have been obvious even though the examiner points to not one of the claimed elements/steps having a corresponding teaching in the applied reference. It is unclear from the examiner's explanation, exactly what elements/steps of Angles are considered to correspond to the claimed elements/steps.

It is clear to us that Angles teaches a method of delivering advertisements to a consumer's computer and, in doing so, there is a transmission of a prompt for personal information from a main computer to a personal computer and also a transmission of personal information from the personal computer to the main computer in response to the prompt. It is clear from column 3, lines 18-28, of Angles, that the reference suggests the claimed transmission of a prompt for, and transmission of, personal information data from/to a main computer and a personal computer.

However, the examiner has never explained where, in Angles, is to be found the claimed "generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information."

We note that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyperlinks to other information and that the "hyper-links typically direct the user's Internet browser to access different websites on the Internet." In our view, one may fairly interpret this disclosure as a teaching of "generating page data defining a web page based upon said personal information" since the advertisements sent to a consumer in Angles are based on personal

information of the consumer and the hyper-links in the advertisement lead to a web page which is generated from some page data. But, even if we accept such an interpretation, and we do, this still does not reveal where the claimed limitation of "assigning a web page address to said web page based upon said personal information" is to be found, or suggested, in Angles.

In responding to appellants' arguments, the examiner merely replies with general platitudes regarding the law on obviousness as well as "cogent reasons to modify the teachings of Angles," (answer-page 59). The examiner cites various cases, and various portions of Angles, at pages 58-69 of the answer, but the examiner never offers any specifics as to just how, exactly, specific teachings of Angles are considered to disclose or suggest the specific claim limitations, especially the limitation anent "assigning a web page address..."

Generalities are not sufficient to establish obviousness under 35 U.S.C. § 103. The examiner must give specifics as to how the prior art is applied against the claimed subject matter. "[T]he Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Similarly, the examiner must also make findings based on material facts documented on the record. Yet, the examiner, in this case, has not shown how, in accordance with the record of this case, Angles suggests "assigning a web page address to said web page based upon said personal information." The examiner may not merely allege obviousness, without finding a single claimed element/step in the reference, by stating that the disclosure of Angles "supports customization..."

At page 68 of the answer, the examiner asserts that teachings in an unapplied reference to Legarde anent associating URLs and hyper-links with assigning a web page address to a web page based on personal information, would have been "inherently disclosed in Angles in view of Legarde."

Not only is it not understood how the assigning of a web page address to a web page based on personal information can be "inherent," but the examiner appears to be basing this "inherency," indeed, basing the entire rejection, on a reference which is not even part of the statement of rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the

rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

While there may possibly be some convincing reason why the disclosure in Angles might be considered to obviate the instant claimed subject matter, within the meaning of 35 U.S.C. § 103, by somehow suggesting the claimed "assigning a web page address to said web page based upon said personal information," the examiner clearly has not provided it.

Accordingly, we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 as set forth by the examiner.

With regard to claims 41-67, we will sustain the rejection of these claims under 35 U.S.C. § 103 because these claims do not include the limitation of "assigning a web page address to said web page based upon said personal information." Rather, these claims merely recite the generation of page data defining a web page based on the personal information and the transmission of the page data. As explained, supra, we consider the disclosure of Angles, at column 4, lines 7-9, to suggest such a generation and transmission of page data.

Even where some of the claims, e.g., claim 50, recite a "personalized web page," this is considered suggested by the hyper-links in Angles because these hyper-links lead to a web

page as a result of the personal information. Accordingly, the web pages displayed as a result may be considered "personalized web pages."

In claim 42, there is a step of "communicating a web page address for said web page" recited. However, this is different from the recitation, in claim 32, for example, of "assigning a web page address to said web page" because there is no assignment. Rather, claim 42 merely requires a communication of a web page address for a web page, which may be the web page to which the hyper-link takes the user in Angels. It does not require assigning a web page address to the web page, that was defined by the generation of page data, based upon the personal information.

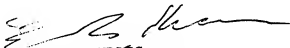
Accordingly, we will sustain the rejection of claims 41-67 under 35 U.S.C. § 103, but we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103.


The examiner's decision is affirmed-in-part.

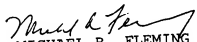
Appeal No. 2004-0738
Application No. 09/401,198

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART


ERROL A. KRASS
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)
)

EK/RWK

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

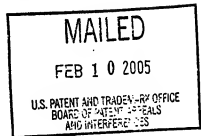
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738
Application No. 09/401,198

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request a rehearing and reconsideration of that part of our decision of November 30, 2004 wherein we affirmed the examiner's decision rejecting claims 41-67 under 35 U.S.C. § 103. Appellants do not seek rehearing on that part of our decision wherein we reversed the examiner's decision with regard to the rejection of claims 32-40 under 35 U.S.C. § 103.

Treating paragraph II of the request for rehearing first, appellants contend that references in our decision to sustaining or not sustaining a rejection are improper since 37 CFR 41.50 authorizes the board to "affirm" or "reverse" rejections of an examiner, but not to "sustain" or "not sustain" such rejections.

In our view, "affirm" is synonymous with "sustain" and "reverse" is synonymous with "not sustain." While our final decision is to affirm, reverse or affirm-in-part the decision of an examiner, sometimes we will state that individual rejections, comprising the examiner's decision, are "sustained" or "not sustained." In any event, this "argument" by appellants is superfluous as it has no bearing on the merits of our decision or, for that matter, on anything else.

On a matter of more real concern to appellants, they argue that our affirmance of the examiner's decision with regard to claims 41-67 was not based on the same grounds as the examiner's original rejection and, therefore, we should have expressly indicated that we imposed a new ground of rejection under 37 CFR 41.50(b).

In particular, appellants assert that our reasoning that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyperlinks to other

information, that the hyper-links typically direct the user's Internet browser to access different websites on the Internet, and that therefore, Angles suggests "generating page data defining a web page based upon said personal information," is reasoning not relied upon by the examiner and, thus, our rationale for sustaining the rejection of claims 41-67 constitutes a new ground of rejection.

We have reconsidered our decision in view of appellants' comments and we do not believe that our rationale constituted a new ground of rejection. The examiner used essentially the same rationale, at page 6 of the answer, wherein it stated, with regard to the obviousness of the claimed subject matter in view of Angles, that Angles supports customization "which can contain hyper-liinks to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet. . . ." Thus, it is clear that the examiner was relying on the same rationale as we stated, i.e., that advertisements sent to a consumer's computer may contain hyperlinks to other information, and that these hyperlinks direct the user's Internet browser to access different websites. Thus, if the advertisements, which are sent to a consumer based on personal information, are said to be "page data" (i.e., the

advertisement page contains data including a hyperlink) and the hyperlink (the hyperlink defining a web page since clicking on this hyperlink will send the user to that web page) in that page data is directed to a certain web page, it can be reasonably said that Angles generates page data defining a web page based on personal information, as claimed.

Appellants assert, at page 10 of the request for rehearing, that "a hyper-link is not a web page." It is true that the hyper link is not, itself, a web page, but clicking on the hyperlink results in a direct connection to the web page for which the hyper link is the address. Accordingly, if page data defines a hyper link, by the hyper link's inclusion in that page data, and the hyper link leads directly to a specific web page, then the generated page data may very well be said to define that web page.

Appellants also maintain that our decision does not expressly identify which claims are being discussed when we indicate that the examiner failed to make a prima facie showing, and that our statements in that regard appear to be generic and cover all the allegations in the final rejection and/or the examiner's answer (request for reconsideration-page 11).

While appellants do not identify the portion of the decision to which they refer, we assume appellants are directing the argument to pages 4-7 of our decision. Therein, we do recite various deficiencies in the examiner's case, but it is clear, from page 8 of the decision, below the listing of the deficiencies in the examiner's case, that our prior discussion related to the rejection of claims 32-40, since we summarize by saying, "Accordingly, we will not sustain the rejection of claims 32-40. . . as set forth by the examiner." Immediately, in the next paragraph, we begin to discuss our view of the rejection of claims 41-67. Therefore, a closer reading of the decision shows that we do, indeed, identify only the rejection of claims 32-40 as failing to show a case of prima facie obviousness.

At page 12 of the request for rehearing, appellants argue that our decision does not address the argument at page 7, lines 14-15, of the principal brief, wherein the examiner admitted that Angles does not expressly disclose claimed limitations.

We do not find appellants' argument persuasive. The examiner merely contended that while Angles did not *expressly* teach each and every element of the claimed subject matter, the claimed subject matter as a whole would have been obvious for the examiner's stated reason. Yet, at page 7 of the principal brief,

to which appellants direct our attention, there is no specific argument by appellants as to what, exactly, is the alleged error in the examiner's case. To merely state that a reference does not teach a certain claimed element, without any explanation as to the reasons deemed by appellants to distinguish the claimed subject matter over the reference disclosure, or as to the alleged errors in the examiner's case, does not constitute a convincing argument for rebutting the examiner's prima facie case.

At page 12 of the request for rehearing, appellants contend that our decision to sustain the rejection of claim 44 is at odds with our factual conclusion that Angles does not disclose or suggest assigning a web page address based upon the personal information. We disagree.

We did not sustain the rejection of the claims reciting "assigning a web page address to said web page based upon said personal information." But claim 44 is directed to the personal information comprising an identity code and that a page address for said web page depends upon said identity code. There is no direct recitation, in claim 44, of "assigning" the address for the web page based on the personal information. Thus, we find no

inconsistency between our finding with regard to claim 44 and our finding with regard to claim 32.

At page 12 of the principal brief, appellants further argue that we misapprehended or overlooked the argument at page 9 of the principal brief, relating to the purchase history database, and that we misapprehended the examiner's incorrect conclusion regarding claim 46, that Angles' storage of a cookie containing a consumer's ID on a user's computer suggests "storing in a purchase history database data identifying products purchased in association with said identity code."

Again, we found that the examiner established a case of prima facie obviousness, which was not argued by appellants. It is not an argument for appellants to merely recite that a reference does not disclose or suggest a particular claimed feature, when the examiner has indicated that it does, without specifically pointing out the error in the examiner's reasoning. With no argument pointing to an error in the examiner's rationale, we will accept the examiner's finding as being correct. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See 37 CFR § 41.37(c)(1)(vii).

Similarly, appellants' "arguments" at page 9 of the principal brief (see page 13 of the request for rehearing) are not persuasive because they point to claim limitations without any specific argument as to how such limitations allegedly distinguish over the claimed subject matter. These "arguments" fail to point to any specific error in the examiner's rationale. Accordingly, we will accept the examiner's findings as being correct.

We have considered appellant's request for rehearing and reconsidered our decision in view of such request but, remaining unconvinced of any error in our decision, we deny appellants' request anent making any changes in our decision.

Appeal No. 2004-0738
Application No. 09/401,198

NEIFELD IP LAW, PC
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

Certificate of Service

I certify that on October 6, 2006, I caused a copy of the foregoing Notice of Appeal, Fourth Appeal Brief, Appendix 1, Appendix 2 and Appendix 3 to be transmitted by First Class U.S. Mail to the third party requestor at the following address:

Thomas G. Scavone
Niro, Scavone, Haller, Niro
181 West Madison Street, Suite 4600
Chicago Illinois 60602

10/6/06
Date


Daniel Sachs

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER, and WILL GARDENSWARTZ

Appeal 2006-2100
Application 08/873,974
Technology Center 3600

Decided: January 29, 2008

Before JOSEPH F. RUGGIERO, HOWARD B. BLANKENSHIP, and
DAVID B. WALKER, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal from the Examiner's rejection of claims 50-89,
which are all the claims remaining in the application. We have jurisdiction
under 35 U.S.C. §§ 6(b), 134(a).

We reverse. ✓

I. The Invention

Appellants' invention relates to systems for delivering incentives and related information to consumers via a computer network that links the consumers to network sites provided by product retailers and by manufacturers. (Spec. 1: 6-10.) Claim 50 is illustrative:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

II. The References

The Examiner relies on the following references as evidence of unpatentability:

Sloane

US 5,918,211

Jun. 29, 1999
(filed May 30, 1996)

Narasimhan US 6,237,145 B1

May 22, 2001
(filed Aug. 14, 1996)

III. Procedural Background

In a decision by the Board mailed July 29, 2004, the Board reviewed the Examiner's rejection of claims 50, 51, 60, 61, 70, 71, 80, and 81 under 35 U.S.C. § 102(e) as being anticipated by Sloane, and the rejection of claims 52-59, 62-69, 72-79, and 82-89 under 35 U.S.C. § 103 as being unpatentable over Sloane in view of Narasimhan. The rejection of the claims under 35 U.S.C. § 102(e) was affirmed. The rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103 was affirmed, *pro forma*, because no substantive arguments on Appellants' part were found in response to the rejection. Although there were affirmed rejections, the proceeding was remanded to the Examiner to either withdraw the rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103, or reopen prosecution, because the rejection was found to be an improper new ground of rejection.

In a decision on Request for Rehearing (mailed Sep. 30, 2004), the Board noted the difficulty in determining the arguments that had been presented in opposition to the rejections, as Appellants had filed various briefs, and supplemental briefs, which attempted to incorporate by reference earlier briefs. The Request was denied to the extent of making any modification in the earlier decision of July 29, 2004.

Appellants filed an appeal to the U.S. Court of Appeals for the Federal Circuit on November 23, 2004. The Court remanded the case to the USPTO (Mar. 9, 2005) upon consideration of Appellants' unopposed motion. The Board's decision was not a final decision ripe for judicial review. *See* 37 C.F.R. § 41.50 (e) (effective Sep. 13, 2004) ("Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.").

In due course, the Examiner mailed a non-final rejection (Jul. 12, 2005) that set forth a rejection of claims 63, 73, and 83 under 35 U.S.C. § 103(a) as being unpatentable over Sloane, and a rejection of claims 54, 64-69, 74-79, and 84-89 under 35 U.S.C. § 103(a) as being unpatentable over Sloane and Narasimhan.

Appellants in response filed the Appeal Brief¹ (Dec. 12, 2005; styled as a reply brief), to which the Examiner responded in turn by the (most recent) Examiner's Answer mailed March 13, 2006. Finally, Appellants filed the Reply Brief in response, on March 17, 2006.

The Examiner, in the most recent Answer, repeats the rejections set forth in the Non-Final rejection of July 12, 2005. In the Examiner's view, the instant appeal does not involve claims 50-53, 60-62, 70-72, and 80-82, as

¹ Appellants submit that we should review an earlier rejection under 35 U.S.C. § 112, first paragraph, that was withdrawn by the Examiner and is thus not before us. We decline, as did the earlier Board panel, to review a rejection that no longer exists and which represents no current controversy.

the rejection of those claims was earlier sustained by the Board. The rejections are not repeated in the most recent Answer.

IV. Representative Claims 50, 54

Claim 54, rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloane and Narasimhan, depends from claim 50. To understand claim 54 thus requires that we understand the limitations of the base claim that claim 54 incorporates by reference. Our review of the rejection of claim 54 also requires that we understand the rejection applied against claim 50 (as being anticipated by Sloane), since claim 54 is rejected over the combined teachings of Sloane and Narasimhan.

Appellants have presented arguments in the Appeal Brief that convince us of error in the rejection applied against representative claim 54, and against all the independent claims rejected under § 102(e) over Sloane. We would normally not re-visit a decision by an earlier panel of the Board. We will do so, however, in view of the particular circumstances of this case. First, as we have noted, we must understand the rejection applied against claim 50 to understand the rejection applied against claim 54. Further, as the earlier panel noted, the arguments presented to that panel were difficult to ascertain because of the multiple briefs and the arguments scattered throughout.² Still further, we are not reversing the decision of the earlier

² Appellants' current Appeal Brief does not purport to incorporate other papers by reference, nor should it. See 37 C.F.R. § 41.37 ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to

panel because, as we have noted, the decision was not a final decision of the Board. The Board was free to reconsider the decision in the event that the application returned to the Board's jurisdiction. Finally, the record before this panel has been supplemented by Appellants' current briefs, and thus constitutes a record different from that upon which the earlier panel based its determinations. If the case had been returned to the earlier panel, that panel might well have decided that the record then before the panel required that the earlier-affirmed rejections be reconsidered.

V. Section 102 rejection over Sloane

The Examiner applies a rejection against all the independent claims (50, 60, 70, and 80) under 35 U.S.C. § 102(e) as being anticipated by Sloane at pages 7 and 8 of the Non-Final Rejection mailed September 23, 2002, repeated at pages 3 and 4 of the Answer mailed March 11, 2003 ("03 Answer").

Sloane describes a system in which a consumer receives a portable bar code scanner (20; Fig. 2a) when entering a retail establishment. Sloane col. 5, ll. 29-51. When the consumer scans a product, display 34 (Fig. 2a) will show the product's price, in addition to showing any promotional information available for that product or a related product. Col. 6, ll. 20-25. The bar code scanner 20, in conjunction with retailer computer/controller 12 (e.g., Figs. 5 and 6), will, *inter alia*, maintain a running total of the

§ 41.41 will be refused consideration by the Board, unless good cause is shown.").

purchases made by the user, and enable the user to view the current savings on the shopping trip. Col. 6, l. 64 - col. 7, l. 3.

As set forth in the '03 Answer (at 4), the Examiner finds that the retailer computer/controller of Sloane is “analogous to” the cooperative network site and the sender (16; Fig. 3b) of Sloane is “analogous to” the manufacturer. The Examiner reads the claimed “consumer computer” on the portable bar code scanning device of Sloane. The “wherein” clause of claim 50 is deemed to be met by the description at column 7, line 65 through column 8, line 7, and at column 8, lines 44 through 48.

Claim 50 recites, *inter alia*, wherein “said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request *made over said communication network from one of said manufacturer network site and retailer network site*” (emphasis added). The statement of the rejection ('03 Answer 4) ends with “in response to a consumer request...,” and does not indicate how the rest of claim 50 might be met by Sloane.

However, the '03 Answer appears to offer an explanation of how the language is met, in the “Response to Argument” section.

[T]he cooperative network site is represented in Col. 7, lines 15-22 by the on-line computer network (LAN OR WAN). This computer network acts as the cooperative network site since this addition allows the manufacturer computer system to communicate with the retailer computer system. Also, Sloane shows that a consumer request can be incorporated into the system in Col. 2, lines 17-21. In this case, the consumer

requests a promotion/coupon through an on-line computer network. Also col. 7, lines 4-15 show that when a consumer selects an item (analogous to the consumer request), the sender of the promotional information sends the information to the retailer computer. In this case, the consumer's request triggers the transmittal of the promotional information from the manufacturer's system to the retailer's system.

('03 Answer 11-12.)

Sloane provides:

Other methods of issuing electronic coupons or promotions to the consumer's frequent shopper electronic account includes consumer requested promotion/coupons through the use of their home computer and an online computer network, such as, for example, the internet.

Sloane col. 2, ll. 17-21.

The text at column 2, lines 17 through 21 of Sloane might show that a consumer request "can be" incorporated into the inventive system of Sloane, but that seems to relate to an inquiry into obviousness. The rejection, however, is under § 102 for anticipation. The "other methods" described by Sloane in column 2 are in the context of describing the prior art in relation to Sloane; i.e., the text at column 1, line 15 through column 2, line 49 describes "The Prior Art."

Sloane further provides:

FIG. 3a shows the first step of the method according to the invention. A retailer 14 designates items that are on sale, or offered with some other consumer promotion or message, and instructs the retailer computer/controller 12 to offer these promotions to the consumer when one of the subject items or

related items are selected (i.e., scanned) by the consumer. FIG. 3b shows an alternative first step to the method where the sender of promotion information 16 can be someone other than the retailer, such as, for example, the product manufacturer. The sender of promotion information 16 sends the information to the retailer computer/controller 12 via communication line 200.

Sloane col. 7, ll. 4-15.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). “[A]bsence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

We do not find any support in Sloane for the Examiner’s finding that the sender of the promotional information sends the information to the retailer computer when the consumer selects an item, or that the consumer’s request triggers the transmittal of the promotional information from the manufacturer’s system (16; Fig. 3b) to the retailer’s system. For example, Sloane’s drawings indicate information transfer between the portable bar code scanning device and the retailer computer/controller 12 (e.g., Figs. 5 and 6), which is separate from the reception by the retailer computer of promotion information by sender 16 (Fig. 3b). “Retailer computer/controller 12 is programmed to receive and store the promotional information sent by

retailer 14 or sender 16, and can therefore offer the promotions at the appropriate time and to the appropriate consumer.” Sloane col. 7, ll. 22-26.

Nor do we find that Sloane inherently describes the material that the rejection attributes to the reference.

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). In Sloane, information is *not necessarily* transmitted to the consumer in response to a consumer request made over the communication network from the retailer network site, because retailer computer/controller 12 can already possess the information received from sender (or manufacturer) 16 when the consumer selects an item, consistent with the express disclosure.

VI. The Rejections

For the foregoing reasons in Section V, Sloane fails to provide sufficient support for the Examiner’s finding of anticipation with respect to independent claim 50. Each of the other independent claims (60, 70, and 80), rejected under § 102(e) over Sloane, contains substantially the same limitations of claim 50 that we consider to be not met by the reference. Because the remaining rejections do not remedy the basic deficiency in the

rejection applied against the independent claims, we cannot sustain any rejection on appeal.

CONCLUSION

The Examiner's rejections of claims 50-89 over the applied prior art are reversed.

REVERSED

pgc

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304